



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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In re Reissue Application of: Michael E. Reedy and Edward W. Rider, Jr.

Serial Number: 09/677,746

Primary Examiner: Allan R. Kuhns

Filed: October 3, 2000

Group Art Unit: 1732

Patent No.: 5,817,261

Issued: October 6, 1998

For: PROCESS FOR PRODUCING ALKENYL AROMATIC FOAMS- USING A
COMBINATION OF ATMOSPHERIC AND ORGANIC GASES AND FOAMS
PRODUCED THEREBY

Assistant Commissioner for Patents
Washington, D.C. 20231

APPELLANT'S BRIEF

Sir:

(1) **Real Party in Interest**

The real parties in interest for this appeal are the Appellants, Michael E. Reedy and Edward W. Rider, Jr.

(2) **Related Appeals and Interferences**

There are no related appeals or interferences.

(3) **Status of Claims**

Claims 1-50 are pending in the application (*see* attached Appendix). Claims 1-50 are rejected because the Examiner alleges they are based upon a defective reissue declaration (filed November 26, 2001).

Also, in the Advisory Action mailed October 2, 2002, the Examiner raised two additional issues specifically regarding claims 1-18 and the amendments made thereto (Advisory Action mailed October 2, 2002 at p. 3). While the Appellants disagree with the Examiner regarding these two additional issues, they nonetheless submit herewith a draft revised reissue declaration (with the added language highlighted in bold) that they believe renders moot the Examiner's assertions, and which they believe permit claims 1-18 to be placed in condition for allowance.

Without knowing whether the draft revised reissue declaration submitted herewith is or is not acceptable to the Examiner, the Appellants address in this brief the two additional issues specifically regarding claims 1-18 raised by the Examiner in the Advisory Action mailed October 2, 2002. Logically, if this draft revised reissue declaration meets with the Examiner's approval, they would endeavor to promptly have it signed by the inventors and filed in the case. Accordingly, as the Examiner stated in the Advisory Action mailed October 2, 2002, "claims 1-18 could be indicated as allowed and only the issues involving claims 19-50 would be before the Board of Patent Appeals and Interferences" (p. 3).

(4) **Status of Amendments After Final**

The Appellants' Response dated August 26, 2002 was submitted in response to the Final Office Action mailed February 26, 2002 and the Examiner considered this Response.

It is presumed that the Appellants' response to the Examiner's request (p. 2, ¶3 of the Final Office Action dated February 26, 2002) for compliance with 37 C.F.R. §1.173(c), *i.e.*, wherein the Appellants supplied citations to the support in the disclosure of the patent for claims 19-50 (added in the reissue application), was acceptable to the Examiner.

(5) **Summary of the Invention**

The claimed invention of U.S. No. 5,817,261 ("the '261 patent") is directed to a process for producing alkenyl aromatic foams utilizing a combination of atmospheric and organic gases as blowing agent (the '261 patent, col. 3, l. 49 through col. 5, l. 24), preferably using greater than 30% by weight of atmospheric gas (the '261 patent, col. 8, ll. 51-58), and preferably also using a predetermined amount of a masterbatch mix comprising a styrenic polymer, a rubbery block copolymer, and a solid blowing agent (the '261 patent, col. 6, ll. 1-4). Also disclosed are alkenyl aromatic foams produced by the process which exhibit increased densities (the '261 patent, col. 4, l. 21 through col. 5, l. 24; col. 9, ll. 32-43), increased thermoforming capabilities (the '261 patent, col. 9, l. 65 through col. 10, l. 28), increased post-expansion properties (the '261 patent, col. 10, ll. 41-54), and increased retainment of the atmospheric and organic gases (the '261 patent, col. 9, l. 65 through col. 10, l. 19).

(6) **Issues**

A. Is the reissue declaration filed November 26, 2001 defective because the error which is relied upon to support the reissue application not an error upon which a reissue can be based ?

B. As to claims 1-18, is the reissue declaration filed November 26, 2001 defective because: (i) it does not explain why the failure to recite that the blowing agent is "a non-solid blowing agent comprised of a combination of atmospheric and organic gases" is an error such that this language is now included in claims 1, 17 and 18; and (ii) does not address the substitution of "consisting essentially of" for "comprising" after the phrase "an additive for (a)" recited in claims 1, 17 and 18, and the changes to the language of claim 10 ?

(7) **Grouping of Claims**

Claims 1-50 are grouped together, and are directed to a process for producing alkenyl aromatic foams utilizing a combination of atmospheric and organic gases as blowing agent.

(8) **Argument**

A. The reissue declaration is not defective and is based upon proper grounds.

Claims 1-50 are rejected because the Examiner alleges that they are based upon a defective reissue declaration since the error which is relied upon to support the reissue application was not an error upon which reissue can be based (Office Action mailed February 26, 2002, ¶1). In particular, the Examiner asserts that if the newly-added claims 19-50 are considered to be overbroad, then the filing of these claims in this reissue application would have the effect of introducing error into the reissue application, rather than correct any error in the '261 patent (Office Action mailed February 26, 2002, ¶4). The Examiner's comments are incorrect and misleading.

Contrary to the Examiner's assertion, filing claims 19-50 in this reissue application does not introduce error into the reissue application, and the purpose of the amendments made thereto was consistent with the amendments made to claims 1, 10, 17 and 18, *i.e.*, to correct an error in the language of the '261 patent claims ((November 26, 2001 Response, pp. 4-5). As explained in the November 26, 2001 Response, the possibility of claims 19-50 being overbroad only existed prior to the amendments made. In that Response, the open-ended phraseology in claims 19 and 33 (used with respect to the additive) was amended by the Appellants in the same manner as similar language that was used in claims 1, 10, 17 and 18 (November 26, 2001 Response, pp. 4-5). Claims 19-50 were amended to recite that the additive "consists essentially of" rather than "comprises" so that they more specifically identified the blowing agent mixed with the molten

polymer as being a non-solid blowing agent comprised of a combination of atmospheric and organic gases (*Id.*). As a result, the filing of claims 19-50 is proper (and does not introduce error into the reissue) since, as amended, they avoid reciting any possibly overbroad language that was found in the '261 patent claims (*Id.*).

The Examiner also alleges that the reissue declaration is defective since claims to the additive existed previously, and that these claims were subject to a restriction requirement, and that these claims should have been pursued (but was not) in a divisional application (Office Action mailed February 26, 2002, ¶4 at pp. 2-3). The Examiner then states that the "failure to timely file a divisional application is effectively the error leading to the filing of claims 19-50" (*Id.* at p. 3). The Examiner's statements are incorrect and not supported by the facts.

As a preliminary matter, the Appellants have repeatedly stated that a failure to timely file a divisional application is not an error upon which the reissue application is being based (*e.g.*, November 26, 2001, p. 6; August 26, 2002, p. 3). Importantly, the reissue declaration dated November 26, 2001 indicates the error as "claiming more than we had a right to claim" (¶6).

It is undisputed that none of the prior patents to have issued from the application that is now the '261 patent contain claims directed to additives, *per se* (*see*, for example, related U.S. Patent Nos. 5,595,694 and 5,652, 277). It follows that the presently claimed additives could not have been subject to a restriction requirement and thus could not now be claimed using a failure to timely file a divisional application as the error relied upon in this reissue application. In addition, in every instance in a prior application where a restriction requirement was directed (*i.e.*, Serial Nos. 07/995,289; 08/163,010; and 08/702,922), the Appellants traversed the restriction requirements, thus precluding a failure to file a timely divisional application as the error relied upon in this reissue application (*see* the Attachments to the November 26, 2001

Response). Contrary to the Examiner's assertion, the Appellants did not acquiesce to the restriction requirements in these previous applications (Serial Nos. 07/995,289; 08/163,010; and 08/772,922), but instead repeatedly stated that the claims should have been examined together.

Specifically, in Application Ser. No. 07/995/289, the Applicants, during a telephone conversation with the Examiner on May 3, 1993, traversed the restriction requirement imposed (Examiner's Amendment, dated May 4, 1993, p. 3). Also, in Application Ser. No. 08/163,010, the Applicants traversed the restriction requirement on the grounds that the claims were "not patentably distinct" from each other and "should be examined together" (Response to Restriction Requirement, dated October 10, 1994, p. 2). The Applicants noted that "[t]o do otherwise merely serves to increase costs to applicants and the Patent Office" (*Id.*). Lastly, in Application Ser. No. 08/702,922, the Applicants traversed the requirement for restriction and stated that the claims were "clearly all interrelated" and that "all of the groups of claims should be considered and examined together" (Response to Restriction Requirement, dated February 5, 1997, p. 2).

Moreover, the claims added in this reissue application are tied directly to the process claims which were patented in the patent for which reissue is sought and should have been prosecuted with such process claims when they were presented in parent application, Serial No. 08/702,922 (now the '261 patent). Notably, the Applicants are not relying upon a failure to file a timely divisional application in any of these previous applications as the error upon which this reissue application is based (*see* citations above). Contrary to the Examiner's assertion, the newly-added claims 19-50 are tied directly to the process claims of the '261 patent and are they part and parcel of the same invention as the patented process claim.

The Examiner's reliance on *In re Orita*, 550 F.2d 1277 (C.C.P.A. 1977), is misplaced since the facts of this reissue application are distinguishable from that case (wherein the

restriction was not traversed resulting in the missed opportunity to file a timely divisional application). By contrast, the newly-added claims 19-50 in this reissue application were not subject to a restriction requirement in any of the prior applications. These newly-added claims are tied directly to the process claims of the '261 patent. Therefore, these claims added in the reissue application are part and parcel of the same invention as the patented process claims and ought not to have been subject to a restriction requirement even if presented in parent application Serial no. 08/702,922 (now the '261 patent).

As cited by the Appellants in their August 26, 2002 Response, the recent Federal Circuit case, *In re Doyle*, reversed a decision by the Board of Patent Appeals and Interferences (upholding an Examiner's rejection of a reissue declaration), and held that the inventor properly presented an error correctable by reissue. *In re Doyle*, 293 F.3d 1355 (Fed. Cir. 2002).

The *Doyle* Court particularly noted that the doctrine embodied by *In re Orita* did not apply because of several "critical" distinctions. *Doyle*, 293 F.3d at 1360. Specifically, the Court held that (1) the applicant never asserted the reissue claims or anything similar to them in the original application; (2) never agreed to prosecute the reissue claims in a divisional; and (3) should have prosecuted the reissue claims with the claims of the elected group. *Id.* Similarly, the reissue claims presented in this application were not presented in the original application, the restriction requirements were all traversed (*i.e.*, the Appellants never agreed to prosecute the reissue claims in a divisional), and that the claims should have prosecuted together. The Federal Court in *Doyle* particularly noted that "it was crucial that the applicant [Doyle] explicitly agreed to the requirement of independent prosecution of the disputed claims," which is in stark contrast to the present facts wherein the Applicants have repeatedly asserted that the claims presented should be examined together. *Id.* Moreover, the Examiner admits that the "[a]pplicants are now

claiming the additive in broader form than it was previously claimed” (Final Office Action, dated February 26, 2002, p. 3), which is similar to the facts in *Doyle* where the reissue claims were broader than the issued patent claims, thus resulting in an error correctable by reissue. *Id.*

In the most recent communication (Advisory Action mailed October 2, 2002), the Examiner fails to distinguish the situation in *Doyle* from the present application.

First, the Examiner states that one of the reissue claims was “substantially the same” as a claim in the parent application (Serial No. 08/702,922, now the ‘261 patent) and concludes that this distinguishes *Doyle*. However, this mischaracterizes the holding of the *Doyle* case and ignores the full explanation of the Federal Circuit. The Court held that it was “crucial” in earlier cases (such as *In re Orita*) that an applicant “explicitly agreed to the requirement of independent prosecution of the disputed claims (or claims substantially similar to the disputed claims) in a divisional” *Id.* at p. 1359. The Court noted that cases like *In re Orita* cannot be used to support a similar result in situations where “there is simply no agreement” by the applicant to pursue the disputed claims in a divisional. Like Dr. Doyle, the Appellants in the present application did not agree to independent prosecution of the disputed claims.

Second, the Examiner incorrectly concludes that the Court’s comments regarding linking claims distinguish the principle set forth in *Doyle*. However, as the Court states (*Id.* at p. 1360) the reissue claims in *Doyle* could have been prosecuted with the claims of the elected group. This is identical to the situation in the present case where the Appellants’ reissue claims could have (and should have) been prosecuted with the claims of the elected group. Indeed, this is a reason supporting the Appellants’ disagreement to the requirement of independent prosecution of the disputed claims.

B. As to claims 1-18, the reissue declaration is not defective and does explain: (i) why the failure to recite that the blowing agent is “a non-solid blowing agent comprised of a combination of atmospheric and organic gases” is an error such that this language is now included in Claims 1, 17 and 18 and (ii) does address the substitution of “consisting essentially of” for “comprising” after the phrase “an additive for (a)” recited in claims 1, 17 and 18, and the changes to the language of claim 10.

As stated above, the Appellants believe that the draft revised reissue declaration submitted herewith renders moot these two issues relating to claims 1-18, and permits these claims to be placed in condition for allowance. Nonetheless, for purposes of this appeal, the Appellants address these two issues relating to claims 1-18, to the extent that these issues remain before the Board after the Examiner’s evaluation of the draft revised reissue declaration.

In the Advisory Action mailed October 2, 2002, the Examiner raises (p. 3) two additional issues relating to claims 1-18, specifically: that the reissue declaration filed November 26, 2001 is defective because (1) it does not explain why the addition of language to Claims 1, 17 and 18 describing the blowing agent as “a non-solid blowing agent comprised of a combination of atmospheric and organic gases” is an error such that this language is now included in these claims and because (2) it does not address the revised language of Claims 1, 10, 17 and 18 (as indicated in the title above). However, an explanation for these amendments was previously provided by the Appellants in the November 26, 2001 Response (pp. 4-5) and has now been included in the revised reissue declaration. In particular, the open-ended phraseology in claims 19 and 33 (used with respect to the additive) was amended by the Appellants in the same manner as similar language that was used in claims 1, 10, 17 and 18 (November 26, 2001 Response, pp. 4-5). Claims 19-50 were amended to recite that the additive “consists essentially of” rather than

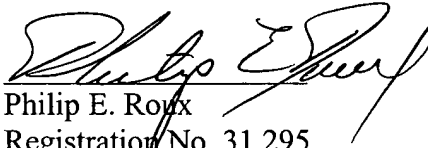
“comprises” so that they more specifically identified the blowing agent mixed with the molten polymer as being a non-solid blowing agent comprised of a combination of atmospheric and organic gases. The Appellants stated that, in the form allowed, original claims 1, 10, 17, and 18, may have been overbroad (*Id.* at p. 4). Similarly, newly-added claims 19-50, were likewise amended since, prior to amendment, they may have been overbroad (*Id.* at p. 5).

(9) **Conclusion**

For the above reasons, the Examiner's rejection of Claims 1-50 should not be sustained.

Respectfully submitted,

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APPENDIX

1. A process for producing a closed-cell polymer foam, said process comprising subjecting a foamable polymer composition comprising: (a) a predominant proportion of an optionally rubber-reinforced alkenyl aromatic polymer; and an additive for (a) consisting essentially of: (b) alpha-methylstyrene, and (c) a rubbery block copolymer to a temperature sufficient to provide a molten polymer; mixing a non-solid blowing agent comprised of a combination of atmospheric and organic gases with said molten polymer; heating the mixture to a temperature and applying pressure such that the mixture does not foam; thereafter reducing the temperature of the mixture; and extruding the mixture.

2. A process according to claim 1, wherein the optionally rubber reinforced alkenyl aromatic polymer (a) is comprised of styrene.

3. A process according to claim 1, wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a copolymer or interpolymer of styrene containing greater than 75 weight percent styrene.

4. A process according to claim 1, wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a blend of styrene and a rubbery polymer.

5. A process according to claim 1, wherein the alpha-methyl styrene (b) has a Vicat softening temperature of between 45 and 82 at 50.degree. C./hr. rise.

6. A process according to claim 5, wherein the alpha-methylstyrene (b) is selected from the group consisting of: a linear homopolymer of alpha-methylstyrene having a molecular weight of about 685, a softening point of about 99.degree. C., and a flash point of about 210.degree. C., a linear homopolymer of alpha-methylstyrene having a molecular weight of about 790, a softening point of about 118.degree. C., and a flash point of about 224.degree. C., and a linear homopolymer of alpha-methylstyrene having a molecular weight of about 960, a softening point of about 141.degree. C., and a flash point of about 246.degree. C.

7. A process according to claim 1, wherein the rubbery block copolymer (c) is selected from the group consisting of A-B, A-B-A, A-B-A-B, graft and radial block copolymers.

8. A process according to claim 7, wherein the rubbery block copolymer (c) is selected from the group consisting of: a styrene-butadiene-styrene block copolymer having a styrene/rubber ratio of about 31/69 (Kraton D-1101); a styrene-butadiene-styrene block copolymer having a styrene/rubber ratio of about 28/72 (Kraton D-1102); a styrene-isoprene-styrene block copolymer having a styrene/rubber ratio of about 14/86 (Kraton D-1107); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 29/71 (Kraton G-1650); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 32/68 (Kraton G-1651); a styrene-ethylene/butylene styrene block copolymer having a styrene/rubber ratio of about 29/71 and a ring and ball softening point (ASTME 28-67, 10% by weight in Kaydol oil) of about 141.degree. F. (Kraton G-1652); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 13/87 (Kraton G-1657X); a styrene-

ethylene/propylene block copolymer having a styrene/rubber ratio of about 37/63 (Kraton G-1701X); and a styrene-ethylene/butylene block copolymer having a styrene/rubber ratio of about 30/70 (Kraton G-1726X).

9. A process according to claim 8, wherein the rubbery block copolymer (c) is selected from the group consisting of: a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 29/71 (Kraton G-1650) and a styrene-ethylene/butylene styrene block copolymer having a styrene/rubber ratio of about 29/71 and a ring and ball softening point (ASTME 28-67, 10% by weight in Kaydol oil) of about 141.degree. F. (Kraton G-1652).

10. A process according to claim 1 further comprising a blowing agent comprised of a mixture of (1) one or more solid organic acids and (2) an alkaline metal carbonate or alkaline metal bicarbonate.

11. A process according to claim 10, wherein the one or more solid organic acids is selected from the group consisting of oxalic acid, succinic acid, adipic acid, phthalic acid and citric acid.

12. A process according to claim 10, wherein the alkaline metal carbonate or alkaline metal bicarbonate is selected from the group consisting of sodium carbonate, potassium carbonate and sodium bicarbonate.

13. A process according to claim 10, wherein the alkali:acid equivalent ratios are from about 1:3 to about 3:1.

14. A process according to claim 13, wherein the alkali:acid equivalent ratio is from about 0.7:1 to 1.3:1.

15. A process according to claim 10, wherein the blowing agent is comprised of a combination of monosodium citrate and sodium bicarbonate.

16. A process according to claim 15, wherein the combination of monosodium citrate and sodium bicarbonate are encapsulated in vegetable oil and the alkali:acid equivalent ratio is from about 0.9:1 to about 1.1:1.

17. A process for producing a closed-cell polymer foam, said process comprising subjecting a foamable polymer composition comprising: (a) an optionally rubber-reinforced alkenyl aromatic polymer comprised of a copolymer or interpolymers of styrene-containing greater than 50 weight percent styrene; and an additive for (a) consisting essentially of: (b) alpha-methylstyrene, and (c) a rubber block copolymer to a temperature sufficient to provide a molten polymer; mixing a non-solid blowing agent comprised of a combination of atmospheric and organic gases with said molten polymer; heating the mixture to a temperature and applying pressure such that the mixture does not foam; thereafter reducing the temperature of the mixture; and extruding the mixture.

18. A process for producing a closed-cell polymer foam, said process comprising subjecting a foamable polymer composition comprising: (a) an optionally rubber-reinforced alkenyl

aromatic polymer, comprised of a blend of styrene and a rubbery polymer, and an additive for (a) consisting essentially of: (b) alpha-methylstyrene; and (c) a rubber block copolymer to a temperature sufficient to provide a molten polymer; mixing a non-solid blowing agent comprised of a combination of atmospheric and organic gases with said molten polymer; heating the mixture to a temperature and applying pressure such that the mixture does not foam; thereafter reducing the temperature of the mixture; and extruding the mixture.

19. An additive suitable for use in a foamable polymer composition, said additive consisting essentially alpha-methylstyrene and a rubbery block copolymer.

20. An additive according to claim 19 further comprising a blowing agent.

21. An additive according to claim 20, wherein the blowing agent comprises a mixture of (1) one or more solid organic acids and (2) an alkaline metal carbonate or alkaline metal bicarbonate.

22. An additive according to claim 21, wherein the one or more solid organic acids is selected from the group consisting of oxalic acid, succinic acid, adipic acid, phthalic acid and citric acid.

23. An additive according to claim 21, wherein the alkaline metal carbonate or alkaline metal bicarbonate is selected from the group consisting of sodium carbonate, potassium carbonate and sodium bicarbonate.

24. An additive according to claim 21, wherein the alkali:acid equivalent ratios are from about 1:3 to about 3:1.
25. An additive according to claim 24, wherein the alkali:acid equivalent ratio is from about 0.7:1 to 1.3:1.
26. An additive according to claim 21, wherein the blowing agent is comprised of a combination of monosodium citrate and sodium bicarbonate.
27. An additive according to claim 26, wherein the combination of monosodium citrate and sodium bicarbonate are encapsulated in vegetable oil and the alkali:acid equivalent ratio is from about 0.9:1 to about 1.1:1.
28. An additive according to claim 19, wherein the alpha-methylstyrene has a Vicat softening temperature of between 45 and 82 at 50°C/hr. rise.
29. An additive according to claim 28, wherein the alpha-methylstyrene is selected from the group consisting of: a linear homopolymer of alpha-methylstyrene having a molecular weight of about 685, a softening point of about 99°C, and a flash point of about 210°C, a linear homopolymer of alpha-methylstyrene having a molecular weight of about 790, a softening point of about 118°C, and a flash point of about 224°C, and a linear homopolymer of alpha-

methylstyrene having a molecular weight of about 960, a softening point of about 141°C, and a flash point of about 246°C.

30. An additive according to claim 19, wherein the rubbery block copolymer is selected from the group consisting of A-B, A-B-A, A-B-A-B, graft and radial block copolymers.

31. An additive according to claim 30, wherein the rubbery block copolymer is selected from the group consisting of: a styrene-butadiene-styrene block copolymer having a styrene/rubber ratio of about 31/69 (Kraton D-1101); a styrene-butadiene-styrene block copolymer having a styrene/rubber ratio of about 28/72 (Kraton D-1102); a styrene-isoprene-styrene block copolymer having a styrene/rubber ratio of about 14/86 (Kraton D-1107); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 29/71 (Kraton G-1650); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 32/68 (Kraton G-1651); a styrene-ethylene/butylene styrene block copolymer having a styrene/rubber ratio of about 29/71 and a ring and ball softening point (ASTME 28-67, 10% by weight in Kaydol oil) of about 141°F (Kraton G-1652); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 13/87 (Kraton G-1657X); a styrene-ethylene/propylene block copolymer having a styrene/rubber ratio of about 37/63 (Kraton G-1701X); and a styrene-ethylene/butylene block copolymer having a styrene/rubber ratio of about 30/70 (Kraton G-1726X).

32. An additive according to claim 31, wherein the rubbery block copolymer is selected from the group consisting of: a styrene-ethylene/butylene-styrene block copolymer having a

styrene/rubber ratio of about 29/71 (Kraton G-1650) and a styrene-ethylene/butylene styrene block copolymer having a styrene/rubber ratio of about 29/71 and a ring and ball softening point (ASTME 28-67, 10% by weight in Kaydol oil) of about 141°F (Kraton G-1652).

33. A foamable polymer composition comprising: (a) an optionally rubber-reinforced alkenyl aromatic polymer and an additive for (a) consisting essentially of: (b) alpha-methylstyrene; and (c) a rubbery block copolymer.

34. A foamable polymer composition according to claim 33, wherein the optionally rubber reinforced alkenyl aromatic polymer (a) is comprised of styrene.

35. A foamable polymer composition according to claim 33 wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a copolymer or interpolymer of styrene containing greater than 75 weight percent styrene.

36. A foamable polymer composition according to claim 33 wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a copolymer or interpolymer of styrene containing greater than 50 weight percent styrene.

37. A foamable polymer composition according to claim 33 wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a blend of styrene and a rubbery polymer.

38. A foamable polymer composition according to claim 33 wherein the alpha-methylstyrene (b) has a Vicat softening temperature of between 45 and 82 at 50°C./hr.rise.

39. A foamable polymer composition according to claim 33 wherein the alpha-methylstyrene (b) is selected from the group consisting of: a linear homopolymer of alpha-methylstyrene having a molecular weight of about 685, a softening point of about 99°C, and a flash point of about 210°C, a linear homopolymer of alpha-methylstyrene having a molecular weight of about 790, a softening point of about 118°C, and a flash point to about 224°C, and a linear homopolymer of alpha-methylstyrene having a molecular weight of about 960, a softening point of about 114°C, and a flash point of about 246°C.

40. A foamable polymer composition according to claim 33 wherein the rubbery block copolymer (c) is selected from the group consisting of A-B, A-B-A, A-B-A-B, graft and radial block copolymers.

41. A foamable polymer composition according to claim 40 where the rubbery block copolymer (c) is selected from the group consisting of: a styrene-butadiene-styrene block copolymer having a styrene/rubber ratio of about 31/69 (Kraton D-1101); a styrene-butadiene-styrene block copolymer having a styrene/rubber ratio of about 28/72 (Kraton D-1102); a styrene-isoprene-styrene block copolymer having a styrene/rubber ratio of about 14/86 (Kraton D-1107); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of 29/71 (Kraton G-1650); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 32/68 (Kraton G-1651); a styrene-ethylene/butylene-styrene block

copolymer having a styrene/rubber ratio of about 29/71 and a ring and ball softening point (ASTME 28-67, 10% by weight in Kaydol oil) of about 141°F (Kraton G-1652); a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 13/87 (Kraton G-1657X); a styrene-ethylene/propylene block copolymer having a styrene/rubber ratio of about 37/63 (Kraton G-1701X); and a styrene-ethylene/butylene block copolymer having a styrene/rubber ratio of about 30/70 (Kraton G-1726X).

42. A foamable polymer composition according to claim 41 wherein the rubbery block copolymer (c) is selected from a group consisting of: a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 29/71 (Kraton G-1650) and a styrene-ethylene/butylene-styrene block copolymer having a styrene/rubber ratio of about 29/71 and a ring and ball softening point (ASTME 28-67, 10% by weight in Kaydol oil) of about 141°F (Kraton G-1952).

43. A foamable polymer composition according to claim 33 further comprising a blowing agent.

44. A foamable polymer composition according to claim 43 wherein the blowing agent comprises a mixture of (1) one or more solid organic acids and (2) an alkaline metal carbonate or alkaline metal bicarbonate.

45. A foamable polymer composition according to claim 44 wherein the one or more solid organic acid is selected from the group consisting of oxalic acid, succinic acid, adipic acid, phthalic acid and citric acid.

46. A foamable polymer composition according to claim 44 wherein the alkaline metal carbonate or alkaline metal bicarbonate is selected from a group consisting of sodium carbonate, potassium carbonate and sodium bicarbonate.

47. A foamable polymer composition according to claim 44 wherein the alkali:acid equivalent ratios from about 1:3 to about 3:1.

48. A foamable polymer composition according to claim 47 wherein the alkali:acid equivalent ratio is from about 0.7:1 to about 1.3:1.

49. A foamable polymer composition according to claim 44 wherein the blowing agent is comprised of a combination of monosodium citrate and sodium bicarbonate.

50. A foamable polymer composition according to claim 49 wherein the combination of monosodium citrate and sodium bicarbonate are encapsulated in vegetable oil and the alkali:acid equivalent ratio is from about 0.9:1 to about 1.1:1.

FULL TEXT OF CASES (USPQ2D)

All Other Cases

In re Doyle, 63 USPQ2d 1161 (CA FC 2002)

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In re Doyle

U.S. Court of Appeals Federal Circuit

No. 01-1439

Decided June 12, 2002

Headnotes

PATENTS

[1] Practice and procedure in Patent and Trademark Office —Reissue — Error without deceptive intent (§110.1303)

Practice and procedure in Patent and Trademark Office —Reissue — Broader claims sought (§110.1313)

Applicant is entitled to reissue of patent in order to broaden claims after failing to present, during prosecution of original application, claims broad enough to read on or “link” two or more groups of claims subject to examiner's restriction requirement, since proposed reissue claims are genus claims that read on nonelected species claims, and thus are substantially broader than claims of nonelected groups, since applicant neither asserted reissue claims in original application nor agreed to prosecute such claims in divisional application, and since applicant could have prosecuted these linking claims with claims of elected group without conflict with restriction requirement; applicant thus has successfully asserted error in issued patent correctable by reissue, and is not subject to rule that precludes reissue applicant from obtaining claims substantially identical to those of nonelected groups identified in restriction requirement if such claims could not have been prosecuted in application from which they were restricted.

[2] Practice and procedure in Patent and Trademark Office —Reissue — In general (§110.1301)

Rule that precludes reissue applicant from obtaining claims substantially identical to those of nonelected groups identified in restriction requirement, if such claims could not have been prosecuted in application from which they were restricted, should not be interpreted to mean that acquiescence to restriction requirement forecloses applicant's right to assert reissue claims to any portion of subject matter of non-elected groups, since rationale underlying rule extends only to claims that are identical, or of substantially similar scope, to those of nonelected group.

[3] Practice and procedure in Patent and Trademark Office —Reissue — Broader claims sought (§110.1313)

Allowing patentee recourse to reissue in order to broaden claims after patentee failed to present, during prosecution of original application, claims broad enough to read on or “link” two or more groups of claims subject to examiner's restriction requirement will not undercut “codependency” requirement of 35 U.S.C. §§120 and 121, since requirement is not implicated if, as in present case, subject matter sought on reissue could have been presented with original application; patentee did not dedicate subject matter of such linking claims to public by failing to file divisional application on nonelected groups in response to restriction requirement, since public knows, or should know, that issued patent can be broadened by reissue during two-year period following issuance.

Particular Patents

Particular patents — Chemical — Catalyzation method

5,296,595, Doyle, method of enantioselectively inserting a carbene, denial of reissue application reversed and remanded.

Case History and Disposition

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Application of Michael P. Doyle (no. 08/601,101) for reissue of patent no. 5,296,595. Applicant appeals from final rejection of claims in application. Reversed and remanded.

Attorneys:

Meredith Martin Addy, Robert N. Carpenter, and Jonathan M. Blanchard, of Brinks Hofer Gilson & Lione, Chicago, Ill., for appellant.

John M. Whealan, solicitor, Mark Nagumo and Henry G. Sawtelle, associate solicitors, Office of the Solicitor, Arlington, Va., for Director, U.S. Patent and Trademark Office.

Judge:

Before Michel, Clevenger, and Schall, circuit judges.

Opinion Text

Opinion By:

Clevenger, J.

Michael P. Doyle appeals the decision of the Board of Patent Appeals and Interferences ("Board") affirming the final rejection of claims 54 through 71 of his Reissue Application No. 08/601,101 based on the doctrine of *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977). *Ex parte Doyle*, No. 2000-0601, slip op. at 12 (December 29, 2000), *request for reh'g denied* (March 22, 2001). Because the Board erred in extending *Orita* to affirm the rejection of the pending claims, we reverse and remand.

I

The invention at issue in this case is a method of using chiral catalysts to catalyze enantioselectively particular classes of chemical reactions. Chiral compounds possess one or more chiral centers—centers that are asymmetric in all dimensions. Like a human hand, a chiral molecule cannot be superimposed on its mirror image, otherwise known as its enantiomer. Altering the relative orientation of the groups bonded to the various chiral centers of a molecule (*i.e.*, creating a different stereoisomer 1 of the compound) can have profound effects on the compound's properties, especially with respect to how the compound interacts with other chiral molecules. These effects are important in pharmaceutical chemistry, among other areas of chemical endeavor, because often only one of the stereoisomers of a particular target compound possesses the desired pharmacological activity. Unfortunately, it is difficult to synthesize only one possible stereoisomer because most reactions produce what is known as a racemic mixture, which is an equal mixture of enantiomers. A category of reactions known as enantioselective reactions, however, will produce either (ideally) one enantiomer or (somewhat less ideally) a mixture that is enriched in a target enantiomer.

The inventor, Michael Doyle, developed a genus of chiral transition metal catalysts and a method of using them to perform enantio-selective reactions with prochiral starting materials.² Dr. Doyle originally filed an application that, according to the examiner, attempted to claim nine different inventions, and included both composition of matter claims and method claims. The examiner imposed a nine-way restriction requirement. Dr. Doyle elected group VI, a group of method claims directed towards using the genus of catalysts to insert carbenes 3 into carbon-hydrogen, oxygen-hydrogen, nitrogen-hydrogen, and silicon-hydrogen bonds. He cancelled the other pending claims. The groups that he did not elect and that are relevant for purposes of this appeal include the following: (1) Group VII, drawn to a method of forming metal stabilized ylides using a chiral catalyst; (2) Group VIII, drawn to a method of adding a hydrogen atom using a chiral catalyst; and (3) Group IX, drawn to methods of adding silicon and hydrogen or boron and hydrogen using a chiral catalyst. The application eventually issued as U.S. Patent No. 5,296,595 on March 22, 1994. Dr. Doyle did not file any divisional applications directed towards the nonelected groups during the pendency of the application that matured into the '595 patent.

On February 14, 1996, approximately one month before the running of the two-year clock for broadening reissues, *see* 35 U.S.C. §251 (1994), Dr. Doyle filed a request for reissue of the '595 patent. He gave as his reason for requesting reissue that

[t]he 595 patent is partially defective because the claims are narrower than they should be in view of the 595 patent's disclosure and the prior art. In particular, all 53 claims of the 595 patent are drawn to a method of enantioselectively inserting a carbene with a chiral catalyst. I now believe that the claims should have been broader in order to cover the use of the defined catalysts to enantioselectively catalyze reactions with a prochiral compound. Thus, Dr. Doyle seeks to broaden his claims to cover the reaction of his catalysts with a genus of prochiral molecules, *i.e.*, not just insertion of a carbene. As Dr. Doyle concedes, the proposed reissue genus claims read on (but are broader than) the claims of nonelected Groups VII-IX.

All of the relevant claims at issue are new claims—not amendments to issued claims. Proposed claim 54 is illustrative of the reissue claims Dr. Doyle seeks:

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A method of enantioselectively catalyzing a reaction comprising the steps of:

providing a prochiral compound,

providing a chiral catalyst comprising

a nucleus with a first and second atom of the same metal aligned on an axis, said metal selected from the group consisting of rhodium, ruthenium, chromium, molybdenum, tungsten, rhenium and osmium; and

first, second, third and fourth bridging ligands oriented radially to the axis,

each ligand having a first and second complexing atom, the first complexing atom of each of said bridging ligands being complexed with said first metal atom, and the second complexing atom of each of said bridging ligands being complexed to said second metal atom,

said first bridging ligand further comprising a ring including said first complexing atom and attached to said second complexing atom, said ring also including a chiral center attached through a first bonding site to said first complexing atom, attached through a second bonding site to said ring, having a third bonding site occupied by a first substituent, and having a fourth bonding site occupied by a second substituent, and

said second bridging ligand further comprising a ring including said second complexing atom and attached to said first complexing atom, said ring also including a chiral center attached through a first bonding site to said second complexing atom, attached through a second bonding site to said ring, having a third bonding site occupied by a first substituent, and having a fourth bonding site occupied by a second substituent, and wherein the R/S configuration of the chiral center on the second bridging ligand is the same as the R/S configuration of the chiral center on the first bridging ligand, and

reacting said prochiral compound and said chiral catalyst under conditions sufficient [sic, to] cause the reaction.

The examiner allowed claims 1-53 of the reissue application, which were identical to the claims of the issued patent, but rejected new claims 54-71. *Ex Parte Doyle*, slip op. at 1. The examiner based his rejection on three grounds: (1) defective reissue declaration based on failure to specify an error correctable by reissue under the *Orita* doctrine; (2) recapture; and (3) obviousness-type double patenting over claims 1-13 of U.S. Patent No. 5,175,311. Dr. Doyle appealed the first two grounds to the Board.⁴ The Board agreed with Dr. Doyle that the recapture doctrine, which prevents an applicant from recapturing through reissue matter surrendered to overcome a rejection based on prior art, is inapplicable here because the pertinent claims were not cancelled to overcome prior art. Rather, they were cancelled in response to a restriction requirement without prejudice to refiling. *Id.* at 11. The Board agreed with the examiner on the first ground of rejection, *i.e.*, that the reissue declaration was invalid under *In re Orita*. *Id.* at 4. Doyle now appeals the *Orita* rejection. This appeal from a final decision of the Board rests within our exclusive jurisdiction pursuant to 28 U.S.C. §1295(a)(4)(A).

II

This case involves a matter of first impression: whether failure to present a so-called linking claim, a claim broad enough to read on—or link—two or more groups of claims subject to a restriction requirement, is an error correctable by reissue. We review *de novo* the Board's legal determination regarding the scope of reissue and the applicability of *In re Orita* to the undisputed facts of this case. *In re Kollar*, 286 F.3d 1326, 1329, 62 USPQ2d 1425, 1427 (Fed. Cir. 2002).

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Section 251 sets forth the requirements for reissuance of a patent:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partially inoperative or invalid, by reason of a defective specification or drawing, *or by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. 35 U.S.C. §251 (1994) (emphasis added). By its terms section 251 restricts reissue to situations in which an error occurred—situations that include the patentee having “claim[ed] more or less than he had a right to claim in the patent.” “The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). Notwithstanding its remedial nature, “[s]ection 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney.” *In re Orita*, 550 F.2d at 1281, 193 USPQ at 149.

Dr. Doyle's reissue application claims appear to come squarely within the mandate of section 251, for they are genus claims that read on, but are broader than, the species claims found in the issued '595 patent. In other words, Dr. Doyle simply seeks a broadening reissue of his '595 patent to cover material that he invented and disclosed, but inadvertently failed to claim in his issued patent. However, our predecessor court long ago held that failure to file a timely divisional in response to a restriction requirement is not an error correctable by reissue. *Id.* at 1280, 193 USPQ at 148; *see also In re Cornell*, 150 F.2d 702, 704, 66 USPQ 320, 322(CCPA 1945); *In re Smyser*, 135 F.2d 747, 751, 57 USPQ 402, 406(CCPA 1943). The so-called *Orita* doctrine therefore precludes a reissue applicant from obtaining substantially identical claims to those of nonelected groups identified in an examiner's restriction requirement when such claims could not have been prosecuted in the application from which they were restricted.

In this case, the Board affirmed the examiner's rejection because, in its view, Dr. Doyle was impermissibly seeking to “circumvent the *Orita* doctrine by presenting reissue claims that encompass not only the subject matter of the canceled, non-elected claims of the original patent application but also additional subject matter.” *Ex Parte Doyle*, slip op. at 7. Thus, in the Board's view, *In re Orita* broadly precludes Dr. Doyle from obtaining reissue claims that read on the subject matter of nonelected groups. We disagree that *In re Orita* compels the Board's decision and hold that section 251 affords Dr. Doyle his requested remedy.

III

In *In re Orita*, the Court of Customs and Patent Appeals addressed whether failure to file a divisional in response to a restriction requirement is an error redressable by reissue. The applicant in *In re Orita* agreed to the restriction requirement and cancelled the nonelected claims. Then, following issuance of the patent on the elected claims, he filed an application for reissue asserting “four additional claims substantially identical to the originally non-elected claims.” *In re Orita*, 550 F.2d at 1278, 193 USPQ at 147. The Board upheld the examiner's rejection of the reissue claims, and the court affirmed, holding that the “error” of failing to file a divisional on the nonelected groups was wholly irrelevant to the question whether any error was present in the patent that issued on the elected claims. The court agreed with the Board that while “appellants undoubtedly erred by failing to file a timely divisional application in order to obtain a divisional patent,” *id.* at 1280, 193 USPQ at 148, the patent that issued on their elected claims was error-free: “Patentees claimed exactly what they had a right to claim in the patent, no more nor less, and appellants' failure to timely re-file does not change this fact.” *Id.* The court also rested its decision on the ground that the patentee knowingly acquiesced in the restriction requirement and that such acquiescence, because it is by definition not inadvertent, cannot be error for purposes of the reissue statute. This interpretation of error flowed from prior cases holding that “the substitution of ‘error’ in section 251 for ‘inadvertence, accident, or mistake’ in former R.S. section 4916 [which governed reissues before it was superceded by section 251] did not involve a substantive change.” *Id.*

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We have applied the rule enunciated in *In re Orita* on one occasion. In *In re Watkinson*, 900 F.2d 230, 231, 14 USPQ2d 1407, 1408 (Fed. Cir. 1990), the applicant acquiesced during prosecution to a two-way restriction requirement. She cancelled her nonelected claims and never filed a divisional application on the nonelected group. Following issuance of the patent on the elected claim, she filed a reissue application seeking to add the nonelected claims. *Id.* She explained that the correctable error lay in her original acquiescence to the restriction requirement, which, she claimed, was improper. *Id.* The Board affirmed the rejection under *In re Orita*, and on appeal, we affirmed. We held that the propriety of the original restriction requirement was immaterial; the key thing was that Watkinson acquiesced to the restriction and was bound by the effect of her original decision: “*Orita* must be read for adhering to the previously established principle that applicants are ‘estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent.’” *Id.* at 232, 14 USPQ2d at 1409 (quoting *In re Orita*, 550 F.2d at 1280, 193 USPQ at 148).

[1] As Dr. Doyle notes, his situation is quite different from those of the applicants in *In re Orita* and *In re Watkinson*. First, Dr. Doyle's new claims are neither identical nor substantially similar to the nonelected claims. Dr. Doyle's new claims are genus claims, whereas the nonelected claims are species that fall within the new genus claims. In other words, the reissue claims are substantially broader than the claims of the nonelected groups. Thus, the estoppel rationale underlying *In re Orita* and *In re Watkinson* does not apply here. In the earlier cases, it was crucial that the applicant explicitly agreed to the requirement of independent prosecution of the disputed claims (or claims substantially similar to the disputed claims) in a divisional, and not as a part of the application directed towards the elected group. When the applicants returned in reissue seeking to add the disputed claims, the examiner, the Board, and this court rightly held them to the terms of their original agreements. The case is different where, as here, the applicant never asserted the reissue claims or anything similar to them in his original application, and also never agreed to prosecute the reissue claims in a divisional application. The estoppel rationale underlying *In re Orita* and *In re Watkinson* cannot support a similar result here because there is simply no agreement as to these particular claims whereby Dr. Doyle may be estopped.

There is another critical, and indeed dispositive difference between the present case and *In re Orita*: Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group. Indeed, as the Solicitor concedes, these linking claims not only could have but *should have* been prosecuted with the elected group. This undercuts the other, more important rationale of *In re Orita*: that the issued patent contains no error. This second rationale underlying the result in *In re Orita* turned on the fact that the applicant could not have asserted the new reissue claims with the elected group. The reason, of course, was the restriction requirement—the examiner specifically required Orita to prosecute those claims in a different application. In contrast, Dr. Doyle could have prosecuted his claims with the elected group without running afoul of the restriction requirement because they are linking claims. See *Manual of Patent Examining Procedure* §809.03 (8th ed. 2001) (“MPEP”). Furthermore, the new claims are broader than the issued claims, and therefore the issued claims are “wholly or partly inoperative or invalid ... by reason of the patentee claiming ... less than he had a right to claim in the patent.” 35 U.S.C. §251 (1994). In other words, Dr. Doyle has successfully asserted an error in the issued patent correctable by reissue and *In re Orita* does not—and cannot—limit his statutory right to seek reissue under the circumstances.

The Solicitor's reliance on the pre-1952 Act cases *In re Smyser* and *In re Cornell* falters under the same rationale. In both of those cases, the applicant tried to seek via reissue claims that, because of a restriction requirement, could not have been prosecuted with the original elected group. In *In re Smyser*, the original application claimed sandpaper, a process of making sandpaper, and an apparatus for making sandpaper. 135 F.2d at 747-48, 57 USPQ at 404. The applicant acquiesced in a two-way restriction requirement between the claims to sandpaper and the apparatus and process claims, and elected the process and apparatus claims. *Id.* at 749, 57 USPQ at 404. He sought to obtain the sandpaper claims via reissue, arguing that the reissue statute “expressly

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provide[s] for the allowance in a reissue application of divisible subject matter” despite the fact that those claims were subject to restriction during the original prosecution. *Id.* at 749-50, 57 USPQ at 405. The court rejected Smyser's argument and affirmed the rejection because “appellant is estopped from obtaining in a reissue application a claim which, because of the requirement for division in which he acquiesced, was not allowable in his original application.” *Id.* at 751, 57 USPQ at 406. Similarly, in *In re Cornell*, we rejected an attempt to claim through reissue apparatus claims that, due to a restriction requirement, the applicant could not prosecute with the original claims. 150 F.2d at 704, 66 USPQ at 322 (“We hold, therefore, that appellants are not entitled to obtain, by reissue, claims, regardless of scope, which are limited to the liquid measuring apparatus per se, and which they conceded by their acquiescence in the requirement for division they were not entitled to claim in their patent.”). In contrast to both *In re Smyser* and *In re Cornell*, Dr. Doyle could have prosecuted his linking claims with the elected group. Therefore an error exists in Dr. Doyle's issued patent (failure to claim the broad genus claims) that did not exist in the *Smyser*, *Cornell*, or *Orita* cases.

Orita, and *Smyser* and *Cornell* (cases upon which *Orita* rests), are best understood for what they are: interpretations of the reissue statute. Each state the correct rule, which is that reissue lies only for correction of error in an existing patent. As noted above, this rationale underlies the decision in each of those cases, where the patent in reissue contained no possible error because the matter sought on reissue could not have been prosecuted originally. That rationale cannot apply to Dr. Doyle's reissue application, in which he points to error in the existing patent, namely, failure to claim as broadly as possible matter that could have been sought in the original application.

[2] The Solicitor views *Orita* as mandating that acquiescence to a restriction requirement forecloses the applicant's right to assert claims in reissue to any portion of the subject matter of the nonelected groups. Thus, in the Solicitor's view, because Dr. Doyle's linking claims read on the subject matter of some of the nonelected groups, he is estopped from seeking in reissue to add those claims to the patent claiming the elected group. The Solicitor takes too broad a view of *In re Orita*. *In re Orita* did not create a broad rule disallowing any reissue claims that read on nonelected subject matter. As discussed above, the reissue claims asserted in *In re Orita* did not just read on nonelected subject matter, but rather were "substantially identical to those non-elected in [the] application." *In re Orita*, 550 F.2d at 1280, 193 USPQ at 149. As discussed above, the rationale underlying *In re Orita* and the holding of that case extend only to claims that are identical to or of substantially similar scope to those of the nonelected group.

The linking claims involved here are obviously not of substantially similar scope as the nonelected species claims—they are quite significantly broader. More importantly, they could have been asserted along with the elected group because they read on the species of the elected group. Indeed, had Dr. Doyle not inadvertently neglected to assert the linking claims in his prosecution of the elected group, and had those claims been allowed, the examiner would have been required to lift the restriction requirement as to the other groups linked by the new claims and allow prosecution of those other groups. The MPEP expressly provides that "[i]f a linking claim is allowed, the examiner *must* thereafter examine species if the linking claim is generic thereto, or he or she *must* examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim." MPEP §809.04 (emphases added). Viewed in this light, Dr. Doyle's failure to assert the linking genus claims truly was an error in the issued patent. It was not, as in *In re Orita*, merely an error pertaining to the prosecution (or lack thereof) of other, divisional applications directed towards the nonelected groups.

The Solicitor also relies on *In re Weiler*, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986), which, in the Solicitor's view, belongs to the *In re Orita* line of cases and supports a broad estoppel based on failure to file a divisional application. The examiner in *In re Weiler* imposed a three-way restriction requirement. Weiler made an election, but failed to file divisional applications to assert the nonelected groups. *Id.* at 1578, 229 USPQ at 674. Following the issuance of his patent on the elected claims, he filed a reissue application asserting new claims that, according to Weiler, "should have been made in the original

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application." *Id.* Following rejection of all the reissue claims, Weiler appealed to the Board. The Board sustained the examiner's rejection of claims 14-18 based on *Orita* because those claims were "directed to the same subject matter as the non-elected conjugate claims 9 and 10 of the original application." *Id.* at 1579, 229 USPQ at 674. The Board sustained the rejection of two other claims (13 and 19) because they are directed to subject matter not claimed at all in the original application. As to them, the Examiner's reliance on the case of *In re Rowand et al.* is entirely correct and that decision is controlling. Here, as in that case, "there is nothing in the original patent evidencing that appellants intended to claim (this now claimed subject matter)." *Id.* (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489(CCPA 1975)).

Weiler did not appeal the *Orita* rejection of claims 14-18 to this court, and we therefore had no occasion to address the propriety of that rejection. He appealed only the rejection of claims 13 and 19. We affirmed that rejection because “Weiler’s failure to have ever claimed, broadly or narrowly or otherwise, the subject matter of claims 13 and 19, and his failure to show an ‘intent to claim’ that subject matter, indicated absence of the statutorily required ‘error.’” *Id.* at 1580, 229 USPQ at 675. Aside from the lack of intent-to-claim, we also rested our decision on the fact that Weiler’s new claims asserted a completely separate invention from the issued claims or any of the nonelected claims. *See id.* at 1581, 229 USPQ at 676. Thus, because claims 13 and 19 claimed a distinct invention from the issued claims, they too would have been subject to the original restriction requirement and the applicant would not have been allowed to prosecute them with the original patent—he would have been required to assert them in a divisional. *Id.* Under *In re Orita*, of course, there is no correctable error in failing to prosecute divisional applications on inventions of the nonelected groups identified by the examiner in the original restriction requirement. In *In re Weiler*, we held that the result should be the same with respect to claims 13 and 19, which also asserted wholly distinct inventions from that covered by the issued patent. *Id.* at 1582, 229 USPQ at 677. We explained that “[i]f it were not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot on the present record have been error to forego divisional applications on subject matter to which claims had never been made.” *Id.*

There is a crucial difference between the situation in *Weiler* and the present case. Dr. Doyle’s claims are not to an invention distinct from that of the issued claims. Rather, as the Solicitor admits, they are linking claims that read on, and could have been asserted with, the elected group. Therefore, the entire premise of *Weiler* is inapplicable to this case, for *Weiler* applies only to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued claims.

The Solicitor also argues that allowing patentees in Dr. Doyle’s position recourse to reissue will undercut the copendency requirements of sections 120 and 121, and will be detrimental to the public interest in the certainty and finality of patent rights. The copendency requirement of section 120 refers to the requirement that a patent application filed as a continuation or divisional application upon an originally filed application must be filed “before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application” in order to receive the benefit of the earlier filing date. 35 U.S.C. §120 (1994). Section 121, which provides for divisional applications, allows an invention that has been the subject of a restriction requirement to receive the benefit of the earlier filing date only if filed in accordance with section 120. Thus, the Solicitor argues that allowing the restricted subject matter to receive the benefit of the earlier filing date via reissue would have the practical effect of circumventing the requirement that the subject matter be claimed in an application filed prior to the issuance of the original patent.

[3] We do not agree. The Solicitor’s argument presumes a situation in which the claims sought on reissue have been restricted from an application in earlier proceedings, *i.e.*, the *Orita* situation. In that situation, the copendency requirements of sections 120 and 121 are relevant. *See In re Orita*, 550 F.2d at 1280-81. In this case, the matter sought on reissue could have been presented with the original

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application, so sections 120 and 121 are not implicated.

As far as the public interest in the certainty and finality of patent rights is concerned, it is certainly true that allowing reissue, and particularly broadening reissue, undermines these various interests to some extent. But Dr. Doyle's situation is no more an affront to the public interest than any other broadening reissue. Congress spoke to this matter when it decided to allow broadening reissues, and we may not rewrite the statute based on our own view of the proper outcome of that public policy debate. Congress has weighed the benefits and burdens of allowing corrections of this sort of error by reissue, and has decided to allow broadening reissues, subject, of course, to certain safeguards: the two-year time limitation and intervening rights.⁵ See 35 U.S.C. §§251-252 (1994) (providing for two-year time limit and intervening rights). These safeguards are no less effective in Dr. Doyle's case than in any other situation in which a patentee alters the scope of his property right through reissue.

The Solicitor also urges us to hold that Dr. Doyle dedicated the subject matter of his linking claims to the public by failing to file a divisional application on the nonelected groups. He urges that "the public is entitled, on the basis of the prosecution of the '595 patent, to conclude that it can practice any of inventions I-V or VII-IX, without apprehension of infringing claims to the non-elected inventions in any patent claiming the benefit of priority of the '595 patent." However, the public knows, or should know, that an issued patent can be broadened by reissue during a two-year period following issuance. The public is therefore on notice that at least some matter can be "dedicated to the public" in error, and that the error, if caught in time, can be corrected by reissue. And if the patentee succeeds in obtaining a reissue that alters the scope of her right to exclude, then the public interest is protected through intervening rights. If those statutory rights are insufficient to protect the public interest in this instance, then the remedy lies with Congress, and not the courts.

IV

For the reasons given above, we reverse the Board's decision affirming the rejection of the pending claims and remand for further proceedings not inconsistent with this decision.

COSTS

No costs.

REVERSED AND REMANDED

Footnotes

¹ Compounds that differ only in the relative arrangement of the groups attached to their chiral centers are known as stereoisomers. Enantiomers, which—as noted above—are nonsuperimposable mirror images of one another, are one type of stereoisomer.

² A prochiral compound is one that, while not yet chiral, can become so when it undergoes a chemical transformation.

³ A carbene is a CR₂ fragment, where R represents a group bonded to the carbon atom.

⁴ Dr. Doyle has agreed to file a terminal disclaimer to cure the double-patenting rejection in the event that he prevails on the other ground for rejection. See *In re Lonardo*, 119 F.3d 960, 965, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) ("Obviousness-type double patenting ... is judicially created and prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. With obviousness-type double patenting ... a terminal disclaimer may overcome that basis for unpatentability, assuming that the first patent has not expired" (internal citation omitted)).

⁵ The doctrine of intervening rights is based on the second paragraph of 35 U.S.C. §252, which "provides that when certain conditions are present a reissue shall not abridge or affect certain rights of those who acted before the reissue was granted. Because of such pre-reissue activity, an infringer might enjoy a 'personal intervening inventing right' to continue what would otherwise be infringing activity after reissue." *Seattle Box Co. v. Indus. Crating and Packing Inc.*, 756 F.2d 1574, 1579, 225 USPQ 357, 361 (Fed. Cir. 1985).

- End of Case -

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suggestion to emerge from the prior art reference may be contrary to that which might appear from an isolated portion of the reference. [59 CCPA at 1260, 465 F.2d at 899, 175 USPQ at 171.]

This is particularly true when the "isolated portion" first considered is, by its own terms, merely an abstract of an incorporated document.⁸

Viewing the descriptions of the hydrolysis reactions in the 131,108 disclosure, the references in Clampitt to "elevated" temperatures and the formation of "amide" groups become significant. The incorporated material teaches that these reactions are conducted at temperatures of from 180°C to 300°C and are continued for many hours. The substantial conversion of ester groups to the amide form and the carboxylate salt form is emphasized. The only implication of acid group formation we find in the incorporated material appears in a description of the manner in which the resultant emulsions may be coagulated by the addition of an acid, presumably by conversion of salt groups to the acid form. Although we have no doubt that acid groups may be introduced into the product of the hydrolysis reaction,⁹ it is not at all clear from the detailed descriptions of these processes that the acid groups are introduced during the hydrolysis proper, or that their presence can be independently attributed to the presence of aqueous ammonia solution.

We note that Example 16 of the 131,108 disclosure actually describes the independent reaction of aqueous ammonia solution with a solid polymer containing pendent carboxylate salt groups. The reaction is carried out at "elevated" temperatures for a relatively long time as would have been

suggested by Clampitt. This appears to be exactly the "second step" of the bifurcated process which the examiner contended those of ordinary skill in the art would have expected to yield a polymer with pendant acid groups. The product of this reaction, however, is stated to be an emulsion wherein "a portion of the carboxylate groups are converted to amide groups" (emphasis ours), and is described as "typical" of the products resulting from the one-step hydrolysis. The formation of acid groups is nowhere suggested.

At best, the teachings of Clampitt, viewed as a whole, would have suggested the formation of acid groups along with amide and carboxylate salt groups by some unspecified mechanism in a high temperature reaction involving the combination of sodium hydroxide and ammonia to produce a polymer in emulsion form. Such a process would have in no way suggested that the reaction could be effected in a film, at ambient temperature, in the presence of ammonia alone, without changing the physical form of the polymer film, all as required by the appealed claims.

[2] Alternatively, Clampitt might reasonably be deemed to have suggested to one skilled in the art the conversion of carboxylate salt groups to acid groups, with an attendant change in form, only by the addition of an acid. In our opinion, that a similar conversion would result from the addition of a base (aqueous ammonia) would have been the epitome of unobviousness. The decision of the board is reversed.

Court of Customs and Patent Appeals

In re Orita, Yahagi, and Enomoti

No. 76-625 Decided Mar. 10, 1977

PATENTS

1. Applications for patent — Divisional (§15.5)

Reissue — Inadvertence, accident or mistake (§58.3)

Reissue applicants' failure to timely file divisional application is not error causing patent granted on elected claims to be par-

Patent 3,970,626, which issued on application serial No. 131,108, is not in the certified record. Appellants' motion to add it to the certified record was opposed by the PTO, and we denied it without opinion October 19, 1976. However, U.S. Patent No. 3,485,785 is of record and purports (p. 5, supra) to have issued on a "continuation" of serial No. 131,108. Appellants' counsel asserted a legal argument that the disclosures of these two patents are identical. We shall so assume. If otherwise, the PTO could not properly have permitted use of the term "continuation." The disclosure incorporated by reference in Clampitt is, therefore, available to us. Appellants would appear to admit this much from their description of a hydrolyzed polymer containing a mixture of carboxylate salt, amide, and acid groups as the starting material in Example 1 in the instant specification.

tially inoperative by reason of claiming less than they had right to claim, in case in which prosecution of original application and resulting patent were error-free and applicants claimed exactly what they had right to claim in patent; applicants' error in failing to timely file divisional application cannot be related back as error correctable by reissue of original patent under 35 U.S.C. 251.

2. Amendments to patent application — In general (§13.1)

Applications for patent — Divisional (§15.5)

Reissue — Inadvertence, accident or mistake (§58.3)

There is no rational distinction between acquiescing in restriction requirement by cancelling non-elected claims and acquiescing by authorizing examiner to cancel them; reissue applicants' acquiescence in examiner's requirement for restriction was not "error" causing them to claim less than they had right to claim in patent granted on elected claims; applicants' failure to timely file divisional application covering originally non-elected subject matter is not germane to any error in prosecution of original application or resulting patent.

3. Applications for patent — Divisional (§15.5)

Reissue — Inadvertence, accident and mistake (§58.3)

Proper restriction requirement would be ignored, and 35 U.S.C. 120 copendency requirement incorporated by reference in Section 121 would be circumvented, if reissue applicants who acquiesced in requirement but failed to timely file divisional application on non-elected claims were allowed to obtain claims substantially identical to them, in reissue of patent granted on elected claims; copendency requirement would become meaningless should applicants prevail, since applicant could revert to Section 251 to cure his mistakes if he failed to file divisional application while maintaining copendency as required by Section 120; Section 251 is not panacea designed to cure every mistake committed by applicant or attorney.

Particular patents — 6

Dialkylaminofluorans

3,442,908, Orita, Yahagi, and Enomoti, 6 Dialkylaminofluorans and Product[s] made Therefrom, rejection of claims 5-8 of reissue application affirmed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for reissue of patent of Michio Orita, Masakichi Yahagi, and Chiyouzi Enomoti, Serial No. 195,468, filed Nov. 3, 1971, division of application, Serial No. 140,287, filed May 4, 1971, for reissue of Patent No. 3,442,908, issued May 6, 1969. From decision rejecting claims 5-8, applicants appeal. Affirmed.

Kenneth J. Stempler, and Bierman & Bierman, both of New York, N.Y., for appellants.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Lane, Judge.

This appeal is from the decision of the Patent and Trademark Office Board of Appeals (board), adhered to on reconsideration, affirming the rejection of claims 5-8 in appellants' application for reissue.¹ We affirm.

Background

Appellants filed original application serial No. 598,590 on December 2, 1966 (application I). As filed, that application contained the following: (1) claims 1-4 to compounds and a method for their preparation, and (2) dependent claims 5-8 to a color-developable coating composition, an emulsion, and a coated sheet. The coating composition, emulsion, and coated sheet all recited, as an essential component thereof, a compound of generic claim 1. The examiner required restriction between these two sets of claims, pursuant to 35 USC 121.² Appellants' counsel, by telephone, elected the compound and compound-preparation claims and preserved the right to traverse the restriction requirement. However, the traverse was never perfected. During prosecution, three compound claims were allowed, and appellants were notified by ex-

¹ Serial No. 195,468, filed November 3, 1971, entitled "6 Dialkylaminofluorans and Product[s] made Therefrom." Claims 5-8 are the only claims in the case.

² 35 USC 121 reads in pertinent part:

§121. Divisional applications.

aminer's amendment that the non-elected claims to coating composition, emulsion, and coated sheet had been cancelled, as authorized by appellants' counsel in a telephone conversation. The last paragraph of the examiner's amendment, dated December 20, 1968, reads:

No traverse is noted in applicants' response to the restriction requirement. Non-elected claims 5-8 have been cancelled as authorized by applicants' attorney [in a telephone conversation of December 12, 1968] * * *.

Upon payment of the final fee, application I matured into U.S. 3,442,908, issued on May 6, 1969.

Appellants filed serial No. 140,287 on May 4, 1971 (application II) for reissue of their patent, presenting therein the three compound claims of their patent and four additional claims substantially identical to the originally non-elected claims. In support of application II, appellants filed a reissue declaration under 37 CFR 1.175,³ wherein they averred, *inter alia*:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. * * *

³ 37 CFR 1.175 reads:

§1.175 Reissue oath or declaration.

(a) Applicants for reissue, in addition to complying with the requirements of the first sentence of §1.65, must also file with their applications a statement under oath or declaration as follows:

(1) That applicant verily believes the original patent to be wholly or partly inoperative or invalid, and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

Applicants verily believe that the original patent, through error without deceptive intention, is partially inoperative by reason of the patentee claiming less than he had a right to claim in the patent for the following reasons: * * *.

By way of explanation why patentee is "claiming less than he had a right to claim in the patent," appellants indicated that they had forgotten to timely file a divisional application covering the originally non-elected subject matter.⁴ Appellants further averred that their failure to file the divisional application was an error without any deceptive intention. The examiner rejected the claims in application II, and this application became abandoned for failure to respond.

However, appellants timely filed the present application (application III) as a division of reissue application II, application III containing only claims 5-8, which are substantially identical to the originally non-elected claims. The examiner rejected the claims in application III on the ground that appellants have not established the requisite error to justify granting a reissue patent, 35 USC 251, para.1.⁵ The board affirmed, and the appeal to us followed.

The Board

The board held that, under the circumstances of this case, failure to file a time-

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) Particularly specifying the errors relied upon, and how they arose or occurred.

(5) That said errors arose "without any deceptive intention" on the part of the applicant.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

⁴ From the reissue declaration, it is apparent that appellants were reminded of their failure to timely file a divisional application by U.S. 3,514,310, which issued to another on May 26, 1970, "for the subject matter of the non-elected invention."

⁵ 35 USC 251, para. 1, reads as follows:

§251. Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by

ly divisional application cannot be corrected by reissue. Reviewing the history of application I, the board found that the prosecution thereof was entirely error-free, and the resulting patent was likewise error-free. In the board's view, the error in failing to file a timely divisional application in order to obtain a divisional patent is akin to an error in failing to file an application before a statutory bar arises. Appellants' error, the board found, cannot be related back as an error correctable by reissue. Regarding the pre-1952 cases of *In re Cornell*, 32 CCPA 1251, 150 F.2d 702, 66 USPQ 320 (1945), and *In re Smyser*, 30 CCPA 1093, 135 F.2d 747, 57 USPQ 402 (1943), as pertinent, the board held that appellants have not established the requisite error to justify granting a reissue patent.

Issue

The issue before us is whether appellants have established the requisite error under 35 USC 251, para. 1, to justify granting a reissue patent containing claims substantially identical to those originally non-elected in application I.

Opinion

[1] We are in substantial agreement with the board's analysis of this case. Although appellants undoubtedly erred by failing to file a timely divisional application in order to obtain a divisional patent, it does not follow that such error caused the original patent to be "partially inoperative by reason of the patentee claiming less than he had a right to claim in the patent" as appellants aver in their reissue declaration under 37 CFR 1.175. We agree with the board that the prosecution of application I and the patent resulting therefrom were error-free. Patentees claimed exactly what they had a right to claim in the patent, no more nor less, and appellants' failure to timely re-file does not change this fact. As the board stated, "Appellants' error cannot be related back as an error correctable by reissue of the original patent under 35 U.S.C. 251."

reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

We further agree with the board that the pre-1952 *Cornell* and *Smyser* cases, cited supra, are pertinent. The basic facts in those two cases and the case at bar are the same. In the two older cases, we held that appellants therein were estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent. Having deliberately cancelled claims to non-elected subject matter, we said, appellants could not successfully contend that their failure to include such claims in their patent was due to "inadvertence, accident, or mistake" as provided in section 64 of former Title 35 (R.S. section 4916; Act of May 24, 1928, ch. 730, 45 Stat. 732).⁶

[2] In the case at bar, as in *Cornell* and *Smyser*, appellants acquiesced in the examiner's requirement for restriction.⁷ Such action manifestly was not "error" causing patentee to claim "less than he had a right to claim in the patent" in the language of current section 251. In this regard, we have previously concluded that the substitution of "error" in section 251 for "inadvertence, accident, or mistake" in former R.S. section 4916 did not involve a substantive change. *In re Wadlinger*, 496 F.2d 1200, 1207, 181 USPQ 826, 831 (CCPA 1974); *In re Byers*, 43 CCPA 803, 230 F.2d 451, 109 USPQ 53 (1956). See also A.R. McCrady, *PATENT OFFICE PRACTICE* Section 218 (4th ed. 1959). Accordingly, appellants have not established the requisite error under 35 USC 251, para. 1, to justify granting a reissue patent. This is so regardless of appellants' emphasis on their failure to timely file a

⁶ R.S. section 4916 reads in pertinent part:

SEC. 4916. Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent.

⁷ We see no rational distinction between *Cornell* and *Smyser*, wherein appellants acquiesced by cancelling the non-elected claims, and the case at bar, wherein appellants acquiesced by authorizing the examiner to cancel the non-elected claims.

divisional application covering the originally non-elected subject matter, which is not germane to any error in the prosecution of application I or in the patent resulting therefrom.

[3] Finally, granting by reissue claims substantially identical to those non-elected in application I would be ignoring the proper restriction requirement set forth in that application in which appellants acquiesced. Indeed, appellants' misapplication of section 251 would, if permitted, circumvent the copendency requirement of section 120,¹ incorporated by reference in section 121 (see note 2 *supra*). Should appellants prevail, the copendency requirement would become meaningless, for should an applicant fail to file a divisional application while maintaining copendency as required by section 120, he could simply revert to section 251 in order to cure his mistake. Section 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure.

In conclusion, we hold that appellants have not established the requisite error under 35 USC 251, para. 1, to justify granting a reissue patent containing claims substantially identical to those originally non-elected in application I. Accordingly, the decision of the board is affirmed.

¹ 35 USC 120 reads:

§120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Court of Customs and Patent Appeals

The Toro Company
v. Hardigg Industries, Inc.

No. 76-588 Decided Mar. 3, 1977

TRADEMARKS

1. Opposition — Failure to take testimony (§67.579)

Opposition — Pleading and practice (§67.589)

Trademark Trial and Appeal Board properly dismissed applicant's argument, which lacked support in record, that its goods were only sold to designated purchasers.

2. Court of Customs and Patent Appeals — Jurisdiction (§28.25)

Court of Customs and Patent Appeals has jurisdiction to entertain appeal from Trademark Trial and Appeal Board decision granting applicant's motion for partial summary judgment, denying opposer's motion for summary judgment and granting its motion to suspend second opposition with applicant that initially sought to register mark, lost first opposition, and, before Court of Customs and Patent Appeals' affirmation, filed second application seeking to register same mark for synonymous goods, alleging same dates of use and including same specimens as first application.

3. Court of Customs and Patent Appeals — Jurisdiction (§28.25)

Court of Customs and Patent Appeals generally does not have jurisdiction over appeals from Trademark Trial and Appeal Board's interlocutory orders or decisions that strike some but not all of party's pleadings, or over decisions that are not "final"; advancement of judicial economy by early decision on *res judicata*, which is sufficiently distinct from likelihood of confusion issue warrants appeal from decision granting applicant's motion for partial summary judgment, denying opposer's motion for summary judgment, but granting its motion to suspend second opposition with applicant that initially sought to register mark, lost first opposition, and, before Court of Customs and Patent Appeals' affirmation, filed second application seeking to register same mark for synonymous goods, alleging same dates of use and including same specimens as first application.



11-10-20-1/301 15-94 41004/36 #6/C 10-21-94
Docket No.: 3142-12

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents and Trademarks, Washington, D.C. 20231, on

Date: October 10, 1994

Signature: [Signature]

ROGERS & WELLS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT OPERATION

In re Application of:
Michael E. Reedy
Edward W. Rider, Jr.

Serial No.: 08/163,010

Group Art Unit: 1306

Filing Date: December 7, 1993

Examiner: A. Kuhns

For: PROCESS FOR PRODUCING ALKENYL AROMATIC FOAMS USING A
COMBINATION OF ATMOSPHERIC AND ORGANIC GASES AND FOAMS
PRODUCED THEREBY

New York, NY 10166-0153
October 10, 1994

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the restriction requirement dated
September 8, 1994, kindly amend the above identified application
as follows:

IN THE CLAIMS:

Cancel Claims 2,3 and 5, without prejudice.

REMARKS

Reconsideration and withdrawal of the restriction
requirement are respectfully requested.

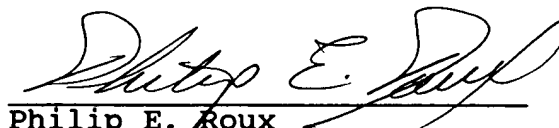
In the Office Action on page two, first full paragraph (1.), restriction to one of the following inventions was required under 35 U.S.C. §121:

- I. Claims 2, 3 and 5, drawn to an alkenyl aromatic foam, classified in Class 521, subclass 91; and
- II. Claims 7-39, drawn to a method of extruding an alkenyl aromatic foam, classified in Class 264, subclass 50.

In response, applicants respectfully traverse the restriction requirement on the grounds that applicants believe the Group I claims, i.e., Claims 2, 3 and 5, are not patentably distinct from the Group II claims, i.e., Claims 7-39. Specifically, applicants believe that a search of the prior art directed to either the Group I or Group II claims would uncover all of the relevant prior art directed to the other group of claims. Therefore, because applicants believe that the examiner will conduct such a thorough examination and review of the prior art, all the relevant prior art directed to both groups of claims will be uncovered and the claims should be examined together. To do otherwise merely serves to increase costs to applicants and the Patent Office. Therefore, applicants respectfully request that the examiner reconsider the restriction requirement, withdraw the same and examine both groups of claims together.

In the event that the examiner disagrees with applicants position and adheres to the restriction requirement, applicants hereby provisionally elect the Group II claims, i.e., Claims 7-39 for further examination.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Philip E. Roux", written over a horizontal line.

Philip E. Roux
Registration No. 31,295

MAILING ADDRESS:

ROGERS & WELLS
200 Park Avenue
New York, New York 10166-0153
Telephone: (212) 878-3153

9/C
8-1594

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, BOX NON FEE AMENDMENT, Washington, D.C. 20231, on

Date: June 30, 1997

Signature:

DEBORAH C. ROBERTS

ua
8/15/97IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Michael E. Reedy and Edward W. Rider, Jr.

Serial No. : 08/702,922 Group Art Unit: 1306

Filed : August 26, 1996 Examiner: A. Kuhns

For : PROCESS FOR PRODUCING ALKENYL AROMATIC FOAMS USING
A COMBINATION OF ATMOSPHERIC AND ORGANIC GASES AND
FOAMS PRODUCED THEREBY200 Park Avenue
New York, New York 10166
June 30, 1997Assistant Commissioner of
Patents
BOX NON FEE AMENDMENT
Washington, D.C. 20231AMENDMENT

SIR:

In response to the Office Action dated March 13, 1997, kindly amend the above-identified application as follows.

IN THE CLAIMS

Cancel Claims 7 and 9, without prejudice.

Amend Claim 8 under the provisions of 37 C.F.R. §1.21(b), as follows.

C4 E 8. A process for producing a closed-cell polymer foam, said process comprising subjecting [the composition of claim 7] a foamable polymer composition comprising: a predominant proportion of (a) an optionally rubber-reinforced alkenyl aromatic polymer; and an additive for (a) comprising: (b) alpha-methylstyrene; and (c) a rubbery block copolymer to a temperature sufficient to provide a molten polymer; [a] mixing a blowing agent with said molten polymer; heating the mixture to a temperature and applying pressure such that the mixture does not foam; thereafter reducing the temperature of the mixture; and extruding the mixture.

Add new Claims 10-24, reading as follows:

10.2 A process according to Claim 8, wherein the optionally rubber reinforced alkenyl aromatic polymer (a) is comprised of styrene.

11.3 A process according to Claim 8, wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a copolymer or interpolymers of styrene containing greater than 75 weight percent styrene.

12.4 A process according to Claim 8, wherein the optionally rubber-reinforced alkenyl aromatic polymer (a) is comprised of a blend of styrene and a rubbery polymer.

13.5 A process according to Claim 8, wherein the alpha-methyl styrene (b) has a Vicat softening temperature of between 45 and 82 at 50°C/hr. rise.

14.6 A process according to Claim 8, wherein the alpha-methylstyrene (b) is selected from the group consisting of: a linear homopolymer of alpha-methylstyrene having a molecular weight of about 685, a softening point of about 99°C, and a flash point of about 210°C, a linear homopolymer of alpha-methylstyrene having a molecular weight of about 790, a softening point of about 118°C, and a flash point of about 224°C, and a linear homopolymer of alpha-methylstyrene having a molecular weight of about 960, a softening point of about 141°C, and a flash point of about 246°C.

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8-1594
ua
8/15/97



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Signature: Deborah Roberts

DEBORAH C. ROBERTS

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Applicants : Michael E. Reedy and Edward W. Rider, Jr.

Serial No. : 08/702,922 Group Art Unit: 1306

Filed : August 26, 1996 Examiner: A. Kuhns

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A COMBINATION OF ATMOSPHERIC AND ORGANIC GASES AND
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200 Park Avenue
New York, New York 10166
June 30, 1997

Assistant Commissioner of
Patents
BOX NON FEE AMENDMENT
Washington, D.C. 20231

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6204/36
#6/C
10-21-94

Docket No.: 3142-12

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Date: October 10, 1994

Signature: [Signature]

ROGERS & WELLS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT OPERATION

In re Application of:
Michael E. Reedy
Edward W. Rider, Jr.

Serial No.: 08/163,010

Group Art Unit: 1306

Filing Date: December 7, 1993

Examiner: A. Kuhns

For: PROCESS FOR PRODUCING ALKENYL AROMATIC FOAMS USING A
COMBINATION OF ATMOSPHERIC AND ORGANIC GASES AND FOAMS
PRODUCED THEREBY

New York, NY 10166-0153
October 10, 1994

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

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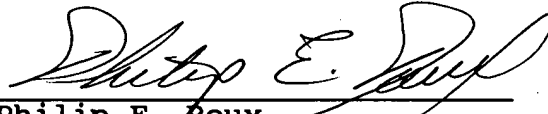
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Philip E. Roux
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your position, as appropriate.

2.

A rejection under 35 U.S.C. 112, first paragraph, should also be made if the new matter is added to the claims or is added to the specification and affects the claims. If new matter is added to the specification and does not affect the claims, an objection should be made based upon 35 U.S.C. 132 using form paragraph 7.28.

1412 Content of Claims

The content of claims in a reissue application is somewhat limited as indicated in MPEP § 1412.01 through MPEP § 1412.03.

1412.01 Reissue Claims Must Be for Same General Invention

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is “an essentially factual inquiry confined to the objective intent manifested by the **original patent**.” *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The “original patent” requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the “original patent” clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was “not originally claimed, not an object of the original patent, and not depicted in the drawing,” does not answer the essential inquiry under the “original patent” clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an “intent,” even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be “for the invention disclosed in the original patent” where:

- (A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and
- (B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

Some disclosure (description and enablement) in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.

The original patent specification would indicate an intent not to claim the subject matter of the claims presented in the reissue application in a situation analogous to the following:
The original patent specification discloses that composition X is not suitable (or not

satisfactory) for molding an item because composition X fails to provide quick drying. After the patent issues, it is found that composition X would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.

1412.02 [R-1] Recapture of Canceled Subject Matter

****>**A reissue will not be granted to “recapture” claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

TWO STEP TEST FOR RECAPTURE:

In *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth guidance for recapture as follows:

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under *Mentor [Mentor Corp. v. Coloplast, Inc.]*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim."

Where a claim in a reissue application is in fact broadened, the examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination.

pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by 35 U.S.C. 251. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998)(Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under 35 U.S.C. 291, pending the outcome of the reexamination, was reversed. The suit under 35 U.S.C. 291 was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue application solely to provoke an interference proceeding before the PTO because it did not assert that there was any error as required by 35 U.S.C. 251 in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

- (A) adds copied claims which are not present in the original patent;
- (B) amends claims to correspond to those of the patent or application with which an interference is sought; or
- (C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application. Note that in *In re Metz*, 1998 U.S. App. LEXIS 23733 (Fed. Cir. 1998)(unpublished), the Federal Circuit permitted a patentee to file a reissue application to copy claims from a patent in order to provoke an interference with that patent. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference if the claims were deliberately omitted from the patent. If there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939)(reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent with which an interference is sought must be less than 1 year prior to the presentation of the copied or amended claims in the reissue application. See 35 U.S.C. 135(b) and MPEP § 715.05 and § 2307. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See 35 U.S.C. 251 and MPEP § 1412.03.

REISSUE APPLICATION FILED WHILE PATENT IS IN INTERFERENCE

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant is required to notify the Board of Patent Appeals and Interferences of the filing of the reissue application within 10 days from the filing date. See 37 CFR 1.660(b) and MPEP § 2360.<

1450 Restriction and Election of Species

The examiner may **not** require restriction in a reissue application (37 CFR 1.176 and MPEP § 1440). Even where the original patent contains claims to different inventions

which the examiner considers independent and distinct, and the reissue application claims the same inventions, the examiner should not require restriction between them or take any other action with respect to the question of plural inventions. Restriction may only be requested by the applicant (37 CFR 1.177 and MPEP § 1451). In situations where a reissue applicant presents claims for the first time that are distinct and separate from the claims of the patent, the examiner must follow the practice resulting from *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) as set forth in MPEP § 1412.01.

A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). Likewise, if the original patent specification shows an intent not to claim the newly presented invention, that invention cannot be added by reissue. In these situations, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. See also MPEP § 1412.01.

When the original patent contains claims to a plurality of species and the reissue application contains claims to the same species, election of species should not be required even though there is no allowable generic claim. If the reissue application presents claims to species not claimed in the original patent, election of species should not be required, but the added claims may be rejected, where appropriate, for lack of defect in the original patent and lack of error in obtaining the original patent as discussed above.

1451 [R-1] Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending

35 U.S.C. 251. Reissue of defective patents.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

37 CFR 1.177. Reissue in divisions.

The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously; if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise.

Questions relating to the propriety of divisional reissue applications and continuation reissue applications should be referred via the Group Special Program Examiner to the Special Program Law Office.

DIVISIONAL REISSUE APPLICATIONS

As is pointed out in MPEP § 1450, the examiner cannot require restriction in a reissue application; only applicant can initiate a division of the claims by demand in accordance with 37 CFR 1.177. Where the original patent claims contain several independent and

of the interpolymer being such that the density ranges from 0.945 down to 0.9, said interpolymer having a melt index within the range of 0.2 to 20, and said interpolymer being further characterized by in wire coating form withstanding more than 1000 hours in air without failure in the Western Electric wire twist test.

40. An interpolymer having impact strength or environmental stress crack resistance properties that are superior to those obtained with comparable free-radical polyethylenes, liner polyethylenes, interpolymers of ethylene and propylene and interpolymers of ethylene and butene, said interpolymer being an interpolymer of ethylene and from 1% to 20% by weight of 4-methyl-1-pentene, said interpolymer having essentially no other copolymerized components, the proportion of the interpolymerized ethylene component therein being not less than 80% nor more than 99% by weight, the percentage crystallinity of the interpolymer being such that the density ranges from about 0.95 at 1% interpolymerized 4-methyl-1-pentene down to about 0.9 at 20% interpolymerized 4-methyl-1-pentene, the melt index of said interpolymer being within the range of 0.2 to 20.

41. Composition of claim 19, wherein said higher olefinic hydrocarbon is n-decene-1.

Court of Appeals, Federal Circuit

In re Amos

No. 91-1298

Decided December 31, 1991

PATENTS

1. Practice and procedure in Patent and Trademark Office — Reissue — Same invention (§110.1305)

Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Board of Patent Appeals and Interferences erred by rejecting reissue claims on ground that applicants lacked objective intent to claim subject matter of new claims at time of original application, and that applicants' failure to claim subject matter was therefore not result of "error" required by 35 USC 251, since rejection under "original patent" clause of Section 251 requires finding that person skilled in art would not, from reading of specification, identify subject

matter of reissue claims as invented and disclosed by patentees, and since board specifically found that subject matter of reissue claims had been disclosed in accordance with 35 USC 112; absence of intent to claim subject matter of reissue claims, even if objectively evident from original claims, drawings, or original objects of invention, does not constitute independent ground for denying reissue application.

Particular patents — General and mechanical — Hold down device

4,610,582, Amos, Greathouse, and Riddle, roller hold down device, rejection of claims 10-12 in application for reissue reversed.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Application of James R. Amos, Chester K. Greathouse, and David S. Riddle, for broadened reissue of patent no. 4,610,582, issued Sept. 9, 1986 (roller hold down device). From decision upholding rejection of reissue claims 10-12, applicants appeal. Reversed.

Marvin Moody, of Hill, Van Santen, Steadman & Simpson, Chicago, Ill., for appellants.

Lee E. Barrett, associate solicitor (Fred E. McKelvey, solicitor, with him on brief), for Commissioner of Patents and Trademarks.

Before Mayer, Lourie, and Clevenger, circuit judges.

Clevenger, J.

James R. Amos, Chester K. Greathouse, and David S. Riddle (collectively, "patentees") submitted an application for a broadened reissue of U.S. Patent No. 4,610,582 ("582 patent"). New claims 10 through 12 were finally denied after appeal to the Board of Patent Appeals and Interferences ("Board") of the U.S. Patent and Trademark Office ("PTO") because the "failure to claim the subject matter of claims 10 through 12 was not the result of the 'error' required by 35 USC 251" since the "objective intent of the patentees" had been to claim only the subject matter in the already issued claims. *In re Amos*, No. 90-3019, slip op. at 8 (BOPAI Feb. 27, 1991). We reverse because the objective intent of the patentees cannot, alone, form the basis for a denial of reissue claims.

I

The 582 patent, which issued on September 9, 1986, claims a set of rollers mounted to hold down a workpiece laid upon a moving table until the end of the table is reached, whereupon the rollers lift away from the table surface. The rollers are designed to lift away so that they cannot fall off the end of the table. 582 patent, col. 1, ln. 15-28, col. 4, claims 1-9. The specification contemplates that lifting will occur automatically:

As the rollers approach the end of the table travel the outside roller is raised either mechanically by the roller cams or electronically by the computer controlling the router. This action prevents the roller from falling off the table and then being damaged as the table moves back against the outside roller.

582 patent, col. 3, ln. 61, col. 4, ln. 2 (reference numbers deleted).

The original claims were not directed to the alternative of using a computer to control the lifting of the rollers. Less than one year after issuance and thus within the statutory time permitted for broadened reissue, the patentees filed a declaration with the PTO that they believed "the original patent to be through error, without deceptive intention, wholly or partly inoperative and invalid for the reason that we claimed less than we had a right to claim in not including claims of the scope of newly submitted claims 10, 11 and 12 which are directed to the concept of controlling the rollers and clamps by the computer." The examiner objected to the declaration because the patentees had not "specif[ied] the errors relied upon, and how they arose or occurred" as expressly required by 37 C.F.R. § 1.175(a)(5) (1988). The Manual of Patent Examining Procedure, at § 1414.03 illustrates the scope of the regulatory provision, by stating, in part:

It is particularly important that the reissue oath or declaration specify in detail how the errors arose or occurred. . . . If the reissue oath or declaration does not particularly specify "how," i.e., the manner in which the errors arose or occurred, the Office will be unable to adequately evaluate reissue applicant's statement in compliance with § 1.175(a)(6) that the "errors arose 'without deceptive intention' on the part of the applicant"; see § 1414.04.

Thereafter, the patentees submitted a supplemental declaration which, in pertinent part, averred:

How this error arose is as follows. Due to mistake and inadvertence during the preparation of the original application which resulted in [the 582 patent], the

attorney who drafted the original claims did not include due to oversight any claims to the combination of the computer for the router which may be connected to control the rollers and the clamps to automatically release them. . . .

After September 9, 1986 when U.S. Patent issued, the inventors asked for an opinion as to whether the allowed claims in U.S. Patent covered a combination for a computer for router which may be connected to control the rollers and the clamps to automatically release. As soon as such request was received, the attorney for applicants studied the issued claims of [the 582 patent] and gave the opinion to the inventors that such combination of the computer was not covered by the issued claims. The inventors then instructed the attorney to prepare and file this reissue application with claims to the computer embodiment.

Supplemental Reissue Declaration at ¶ 4 (reference numbers deleted).

Nonetheless, the examiner finally rejected claims 10-12 because the declaration failed "to particularly specify how the errors relied upon arose or occurred, as required under 37 CFR 1.175(a)(5)." Office Action in U.S. Application Ser. No. 056,784 from PTO Examiner to the patentees (Oct. 17, 1988) at 2. Furthermore, the examiner rejected the claims because they were not "for the same invention as that disclosed as being the invention in the original patent," asserting that this was required by 35 U.S.C. § 251. The examiner stated that there was no "evidence that applicant considered the use of the router computer to control the rollers and the clamps to be their invention." *Id.* (citing *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978)). We read, as did the Board, the examiner's final rejection to be based upon both of two independent prerequisites to reissue, found in 35 U.S.C. § 251, which are that the patentee specify "error without any deceptive intention" and that the Commissioner may not reissue a patent with new claims unless the reissued patent is "for the invention disclosed in the original patent." On the patentees' appeal to the Board, the examiner filed an answer which contended that, additionally, the "disclosure fails to present an enabling disclosure on which claims 10-12 can find support" as required by 35 U.S.C. § 112 ¶ 1.

II

In its opinion, the Board first addressed the examiner's finding that the reissue declaration was legally insufficient under 37

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C.F.R. § 1.175(a)(5) for failing to specify or identify the type of error contemplated by the statute. The Board held:

Our assessment of the supplemental re-issue declaration, however, indicates to us that it complies with 37 CFR 1.175(a)(5). Specifically, we determine that section 4) of the supplemental declaration, bridging pages 2 and 3 thereof, particularly specifies in reasonable detail how the errors relied upon arose by setting forth a chronology of relevant events.

In re Amos, slip op. at 4.

The Board further found that "the subject matter of these claims was disclosed in accordance with 35 USC 112." *Id.* at 8. However, the Board concluded that:

appellants' failure to claim the subject matter of claims 10 through 12 was not the result of the "error" required by 35 USC 251. The subject matter of claims 10 through 12 was not originally claimed, not an object of the original patent, and not depicted in the drawing. Thus, we perceive that the *objective intent* of the patentees manifested in the original patent was to solely claim the invention of claim 1 through 9.

Specifically, appellants submit that there is no manifestation of an *intent* not to claim in the original patent, and argue that the patent clearly shows that they *intended to claim* the control of the rollers and clamps by the computer. The difficulty we have with this advocated position is that appellants do not provide us with any insight as to where the original disclosure evidences an *intent to claim*, and we can find none.

In summary, this board sustains the examiner's rejection of appellants' claims under 35 USC 251, for the reasons given above.

In re Amos, slip op. at 8-9 (emphasis added).

The Board thus specifically declined to affirm the rejection on two of the grounds suggested by the examiner: that the disclosure did not support the claims under § 112 ¶ 1; and, that the supplemental affidavit did not satisfy the statutory requirement that reissue is permitted only upon demonstration of error without any deceptive intention. Rather, the Board found that the disclosure of the original patent failed to set forth an "intent to claim" the subject matter for which protection was sought on reissue.

III

This appeal invites us to address the proper role under 35 U.S.C. § 251, if any, for the

concept of an "intent to claim" in a rejection of claims submitted during reissue. We start, as we must, with the words of the statute, which, in pertinent part, state:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. § 251 ¶ 1 (1988).

The section requires that the patentee base the application for reissue upon one of four specified grounds statutorily-identified as correctable defects. *In re Clark*, 522 F.2d 623, 625-26, 187 USPQ 209, 211-12 (CCPA 1975). First, an asserted defect may arise from an error in the specification. *In re Salem*, 553 F.2d 676, 679, 193 USPQ 513, 516 (CCPA 1977) (reissue permitted to correct specification term "polyvalent anions" to clearly-implied "source of polyvalent anions"). Second, the patentee may correct a defective drawing. The final two reasons for which the patentee may seek reissue concern original claims subsequently discovered to have been either too narrow or too broad. *In re Handel*, 312 F.2d 943, 948, 136 USPQ 460, 464 (CCPA 1963) (purpose of statute is to permit limitations to be added to, or removed from, claims). The basis for seeking narrowing reissue has generally been the belated discovery of partially-invalidating prior art. *In re Harita*, 847 F.2d 801, 805, 6 USPQ2d 1930, 1932 (Fed. Cir. 1988). In contrast, a broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention. *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984) ("attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects"); *cert. denied*, 469 U.S. 1209 (1985); see also *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1575, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991).

In setting forth the purpose of the reissue, the patentee must submit an oath or declaration along with the surrendered patent and a payment of the requisite fee. 37 C.F.R. § 1.172(a) (1988); see 35 U.S.C. § 251 ¶ 3 (1988). "There are two distinct statutory

requirements that a reissue oath or declaration must satisfy. First, it must state that the patent is defective or partly inoperative or invalid because of defects in the specification or drawing, or because the patentee has claimed more or less than he is entitled to. Second, the applicant must allege that the defective, inoperative, or invalid patent arose through error without deceptive intent." *Wilder*, 736 F.2d at 1518, 222 USPQ at 370; see also *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556, 1564-65, 11 USPQ2d 1750, 1757-58 (Fed. Cir. 1989), cert. denied, 110 S.Ct. 1125 (1990).

Finally, the statute restricts the Commissioner to reissuing the patent only "for the invention disclosed in the original patent" with the proviso that "[n]o new matter shall be introduced into the application." The "original patent" clause of § 251 creates a requirement that precludes reissue, historically styled as a "same invention" rejection, of patents with claims to subject matter that could not have been claimed in the original patent that is submitted for reissue.

As is apparent from the foregoing statutory analysis, "[t]he phrase 'intent to claim' does not appear in the statute." *In re Weiler*, 790 F.2d 1576, 1581, 229 USPQ 673, 676 (Fed. Cir. 1986); see also *Scripps Clinic*, 927 F.2d at 1575, 17 USPQ2d at 1009 ("'Intent to claim' is not the criterion for reissue").

IV

In practice, the rejection of reissue claims has been founded upon either a failure to demonstrate error without deceptive intention, see *Weiler*, or because the newly submitted claims are not supported by the disclosure of the "original patent." In the decision before us, the Board specifically rejected the examiner's contention that the supplementary declaration was insufficient to demonstrate "error without any deceptive intention." Thus, we do not read the Board opinion as having rejected the claims because the submitted declaration failed to specify the statutorily-required error.

Thus, we must read the Board's invocation of the "infelicitous" phrase, "intent to

In its brief on behalf of the Board, the Solicitor argues in the alternative that the Board clearly erred in determining that the declaration was sufficient to satisfy the statutory requirement of error without deceptive intention. Assuming, *arguendo*, that the Solicitor's office can challenge the decision of its client, we do not agree. The Board's decision that the supplementary declaration averred sufficient facts to support a finding of error is not clearly erroneous.

claim," see *Weiler*, 790 F.2d at 1580, 229 USPQ at 675, as a decision that the new claims were not "for the invention disclosed in the original patent," or, in the time-honored terminology, were not for the "same invention." We note that the phrase has been oft employed in support of a rejection grounded upon a failure of the patentee to show that the new claims are directed to the "same" invention as that originally disclosed. *In re Rowand*, 526 F.2d 558, 187 USPQ 487 (CCPA 1975); *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). Therefore, the Board's decision must be based upon its determination that the original disclosure does not support the subject matter of the new claims as required by the "original patent" clause of § 251.

We thus must turn to our binding precedent from the Court of Customs and Patent Appeals to understand the legal parameters that support a "same invention" or "original patent" rejection of claims in a reissue application. As noted by that court:

"intent to claim" arose from the requirement that the reissue be for the "same invention" as the original, i.e., that it cover what was "intended to have been covered" by the original [citing 35 U.S.C. § 64 (1946), repealed by Patent Act of 1952, Pub. L. No. 593, § 251, 66 Stat. 792, 808 (1952)].

Thus, in *Rowand* and similar cases, "intent to claim" has little to do with "intent" *per se*, but rather is analogous to the requirement of § 112, first paragraph that the specification contain a "written description of the invention, and of the manner and process of making and using it." It is, as appellant urges, synonymous with "right to claim."

Mead, 581 F.2d at 256, 198 USPQ at 417. Our predecessor court further explained the proper test under the "same invention" or "original patent" statutory arm:

Determining what protection appellants intended to secure by their original patent for the purposes of § 251 is an essentially factual inquiry confined to the *objective* intent manifested by the original patent. *Rowand*, 526 F.2d at 560, 187 USPQ at 489 (emphasis original).

Hence, the purpose of the rubric "intent to claim" is to ask the same question as to whether "new matter" has been "introduced into the application for reissue" thus, *perforce*, indicating that the new claims are not drawn to the same invention that was originally disclosed. That inquiry is but a restatement of the question whether that which is

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claimed in reissue could have been claimed on the basis of the original disclosure, given that the requisite inadvertent error has been demonstrated, as is the case here. Thus, the inquiry that must be undertaken to determine whether the new claims are "for the invention" originally disclosed, to paraphrase *Rowand*, is to examine the entirety of the original disclosure and decide whether, through the 'objective' eyes of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application, given that the requisite error has been averred. We agree with, and, in any event, are bound by, the statement in *Mead*, quoted above, that the inquiry under § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112 ¶ 1. Under one aspect of that analysis, a court must ascertain whether "the disclosure originally filed [conveys] to those skilled in the art that applicant had invented the subject matter later claimed." *Wilder*, 736 F.2d at 1520, 222 USPQ at 372; see also *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978) ("The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.").

Since the Board concluded that the original disclosure embraces the matter claimed in reissue, the Board erred in denying the reissue application on the basis of the lack of an "intent to claim." In the case at hand, the Solicitor, in his brief to this court, expressly concedes that the Board was correct in finding that the patentees' reissue claims comply with the enablement and written description requirements of § 112 ¶ 1. Under *Rowand*, given a satisfactory averment of inadvertent error, this position is arguably inconsistent with a "same invention" rejection. However, the issue of whether the tests, for written description and enablement under § 112 ¶ 1 and for "same invention" under § 251, are in every case exactly co-extensive, neither briefed nor argued in this case, is not properly before us on the instant facts, since the Board's decision rests only upon the factual determination that the patentees' lacked an objective "intent to claim" the new subject matter. We need only decide whether a reissue application can be rejected under the "error" rubric for failure to demonstrate an objective intent to claim, when the Board has held that the subject matter of the reissue claims meets the requirements of § 112 ¶ 1.

[1] We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.²

Our conclusion in this circumstance is dictated by this Court's previous decision in *In re Hounsfield*, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983).³ In *Hounsfield*, the

² The Solicitor cites the case of *U.S. Industrial Chems. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668 [53 USPQ 6] (1942), in support of the Board's use of the phrase "intent to claim." In *U.S. Industrial*, the Supreme Court held that the reissue claims were invalid because the patentees had added new matter to the original disclosure which was the only support for those claims. In the course of the decision, which was based upon the statutory requirement that the reissue claims be for the "same invention," see 35 U.S.C. § 64 (1946), the Supreme Court referred to various other tests under which reissue claims might be held invalid. To the extent that the language of *U.S. Industrial* supports the use of the legal oxymoron, "objective intent to claim," as an analytical tool to discern the scope of the original disclosure, nothing in this opinion, nor in *Mead*, *Rowand*, or *In re Hounsfield*, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983), differs in legal significance. The objective intent to claim found in the original disclosure, insofar as the construct is analytically useful, however, exists as "only one factor that sheds light upon whether the claims in the reissue application are directed to the same invention as the original patent and the reissue would correct an inadvertent error in the original patent." *Hounsfield*, 699 F.2d at 1323, 216 USPQ at 1048.

³ Neither party nor the Board cited or discussed this case. Inexplicably, all three rely instead on dicta from *Weiler*. The issue for decision in *Weiler* was whether the patentee had demonstrated error without deceptive intention, not whether the claims were to the same invention as the "original patent." We do not quibble with the holding in *Weiler* that satisfaction of the § 112 ¶ 1 written description requirement does not establish "error" under § 251. *Weiler*, 790 F.2d at

Board rejected reissue claims on the ground that "the record makes it clear that it was not appellant's intention to claim the subject matter of claims 7 through 11 in the original [131] patent." *Hounsfield*, 699 F.2d at 1321, 216 USPQ at 1046 (quoting the Board). The issue for decision was whether the rejection was sustainable under § 251. This Court concluded that:

lack of "intent to claim" is not an independent basis for denying a reissue application under section 251. It is only one factor that sheds light upon whether the claims of the reissue application are directed to the same invention as the original patent and the reissue would correct an inadvertent error in the original patent.

Hounsfield, 699 F.2d at 1323, 216 USPQ at 1048.

Thus, we conclude, as did this Court in *Hounsfield*, that the presence or absence of an objective intent to claim, standing alone, is simply not dispositive of any required inquiry under § 251.

REVERSED

Court of Appeals, Federal Circuit

The Laitram Corp. v. NEC Corp.

No. 91-1108

Decided December 31, 1991

PATENTS

1. Practice and procedure in Patent and Trademark Office — Re-examination — In general (§110.1501)

Practice and procedure in Patent and Trademark Office — Re-examination — Prior art considered (§120.1505)

Infringement — Defenses — Prosecution history estoppel (§120.1105)

Any amendment to claim during re-examination following rejection based on prior art does not automatically mean that claim has been substantively changed as matter of law and does not create per se estoppel; rather, to determine whether claim change is substan-

1581 n.2, 229 USPQ at 676 n.2. *Weller* did not involve the question of whether § 112 ¶ 1 speaks conclusively to the "original patent" requirement of § 251. See 4 D. Chisum *Patents* § 15.03 [3] n.15 (1991). We have no ready explanation for the Board's or the parties' attention to *Weller* and utter inattention to *Hounsfield*.

tive, claims of original and re-examined patents must be analyzed in light of particular facts, including prior art, prosecution history, other claims, and any other pertinent information.

JUDICIAL PRACTICE AND PROCEDURE

2. Procedure — Summary judgment — Patents (§410.3303)

Interpretation of patent claims is question of law, but summary disposition is nevertheless improper if it is necessary to resolve disputed issues of fact in course of interpreting claims.

Particular patents — Electrical — Printing systems

3,952,311, Lapeyre, electro-optical printing system, grant of partial summary judgment of non-infringement reversed.

Appeal from the U.S. District Court for the Eastern District of Louisiana, McNamara, J.; 17 USPQ2d 1407.

Action by The Laitram Corp. against NEC Corp., NEC Information Systems Inc., and Sears, Roebuck and Co. for patent infringement. From grant of partial summary judgment in favor of defendants, plaintiff appeals. Reversed and remanded.

Timothy J. Malloy, of McAndrews, Held & Malloy, Chicago, Ill. (Larence M. Jarvis, Gregory J. Vogler, and Jean Dudek Kuelper, Chicago, on brief; Phillip A. Wittman and Steven Usdin, of Stone, Pigman, Walther, Wittmann & Hutchinson, New Orleans, La.; Barry L. LaCour and Mark T. Drapanas, Harahan, La., of counsel), for appellant.

John M. Calimafde, of Hopgood, Calimafde, Kalil, Blaustein & Judlowe, New York, N.Y. (Marvin N. Gordon, Charles Quinn, and David H. Kagan, New York, on brief; James D. McMichael, of Liskow & Lewis, New Orleans, La., of counsel), for appellees.

Before Newman, Archer, and Rader, circuit judges.

Newman, J.

In a suit for patent infringement by The Laitram Corporation, NEC Information Systems Inc., and Sears, Roebuck and Co. (collectively "NEC"), the district court judgment in favor of the appellants was affirmed.

The question presented is whether the appellants' motion for summary judgment was properly granted. We conclude that it was not. The judgment must be affirmed because the facts of the case are not in dispute.

Accordingly, the judgment is affirmed and the case is remanded for further proceedings.

United States Patent and Trademark Office (311 patent) entitled "Printing System", issued on April 1, 1991, to the Laitram Corporation, directed to high speed printing, whereby printed matter is produced on a sheet of material. As described, the system includes a radiation emitting straight line and a material is moved at a constant speed, in the line of the sensitive material to produce type characters.

A request for reexamination by a third party, not a patent examiner, was raised as a substantive issue as to claim of the original '311 patent reexamination.

Laitram Corp., 1407 (E.D. La. 1991), 189-1571 (October 1, 1991), *motion to appeal granted*, 11/20/91, Nov. 20, 1990. Jurisdiction to 28 U.S.C. § 1292(a)(1), 35 U.S.C. § 303.

(a) Within three months of a request for reexamination of section 3 of the patent law, the examiner will determine whether a new question of patentability is presented by the request, with or without new evidence or printed

Other evidence points strongly away from a finding of secondary meaning. First is the limited time that the ROXANNE has, been on the market; only about eighteen months. Second is the existence of other similar telephone designs which compete with the ROXANNE design. Since at least 1986, a company called Loys has been making a clear plastic desk telephone with a U-shaped neon tube extending around three sides of the base. While there are significant differences between the Loys telephone and the ROXANNE, the existence of other see-through neon-lit telephones on the market makes it less likely that consumers will associate such phones with a single manufacturer.

These factors, coupled with the complete absence of any consumer studies linking the ROXANNE design with a source, leads us to the conclusion that there is insufficient evidence in the present record to support a finding of secondary meaning. We find the situation here to be very similar to that in the *Stormy Clime* case in which the Second Circuit vacated a preliminary injunction and we are doing so here for many of the same reasons stated in that opinion.

C. Conclusion

Since Cicena has failed to present sufficient evidence to support a finding of likelihood of success on the issue of secondary meaning, we vacate the preliminary injunction on this ground, and do not reach the remaining issues raised by CTG concerning irreparable harm, functionality, and likelihood of confusion. Likewise, we cannot consider Cicena's argument that the injunction could be upheld on the basis of New York state unfair competition law because the district court specifically did not reach this ground and the issue is not before us.

COSTS

Cicena shall bear the costs.

VACATED AND REMANDED

many differences in their shapes, the appearance and structures of their keyboards, and the colors in the internal components.

Court of Appeals, Federal Circuit

In re Watkinson

No. 89-1537

Decided March 30, 1990

PATENTS

1. Practice and procedure in U.S. Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

Practice and procedure in U.S. Patent and Trademark Office — Re-issue — Error without deceptive intent (§110.1303)

Applicant's failure to timely file divisional application for non-elected claim from original application is not error correctable by re-issue under 35 USC 251, regardless of propriety of examiner's underlying restriction requirement, since applicant, by acquiescing in restriction requirement, canceling non-elected claim, and allowing patent to issue on remaining claims, lost her opportunity to challenge propriety of restriction requirement, and since holding otherwise would permit applicant to undermine co-pendency requirements of 35 USC 120 and 121 by using re-issue statute to avoid restriction requirement.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Application of Sarah C. Watkinson for re-issue of patent no. 4,481,219 (inhibition of growth in fungi), issued Nov. 6, 1984. From decision by Board of Patent Appeals and Interferences upholding examiner's rejection of all claims in re-issue application, applicant appeals. Affirmed.

Steven B. Kelber, of Oblon, Spivak, McClelland, Maier & Neustadt, Arlington, Va., for appellant.

John W. Dewhirst, associate solicitor (Fred E. McKelvey, solicitor, with him on brief), for appellee.

Before Baldwin, senior circuit judge, and Archer and Michel, circuit judges.

Baldwin, J.

Sarah C. Watkinson (Watkinson) appeals the decision of the Board of Patent Appeals and Interferences (board), of the United

tion requirement in the original application was an error correctable by reissue because the restriction requirement had, in fact, been improper. She explained that her failure to traverse the restriction requirement was due to her agent's mistaken belief that the invention of claim 38 was unpatentable.

Watkinson's original application, serial no. 06/395,928, filed July 7, 1982, was directed to compositions for and methods of inhibiting the growth of timber fungus. During prosecution, the examiner subjected the application to a restriction requirement, designating the following groups:

Group I, encompassing claims 24, 26-31, 33, 35-37, 43-44, 46, 48-49 and 51, drawn to a composition and method of use thereof, having at least two components; and Group II, encompassing claim 38, drawn to a method of using a composition having only one component.

In response to the restriction requirement, Watkinson elected the claims within Group I for further prosecution and reserved the right to file a divisional application containing claims to the non-elected invention. Watkinson then cancelled non-elected claim 38 and the patent issued on November 6, 1984, without a divisional application having been filed.

A reissue application, serial no. 06/817,286, was filed on January 9, 1986, with claims 1-35 corresponding to those in the '219 patent and claims 36-38 corresponding to claim 38 which had been cancelled from the original application. The examiner rejected all of the claims in the reissue application under 35 U.S.C. §251 (1982)¹ for lack of a statutory error.

Watkinson then appealed to the board arguing that her acquiescence in the restric-

¹ 35 U.S.C. §251, para. 1, reads as follows:
§251. Reissue of defective patents
 Whenever

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The issue in this case is whether the board erred in affirming the examiner's rejection of all the claims in a reissue application under 35 U.S.C. § 251 (1982) when the alleged error was the acquiescence in a restriction requirement in the original application.

We find no error in the board's analysis and conclusion in this case.

In *In re Orita*, the issue was whether the failure to file a divisional application was an error causing the original patent to be partially inoperative and thus correctable by reissue under 35 U.S.C. §251. 550 F.2d at 1280, 193 USPQ at 148. This court's predecessor court found that the failure to file a divisional simply cannot be related back as an error in the issued patent. *Id.* It further stated that "granting by reissue claims substantially identical to those non-elected in application I would be ignoring the proper restriction requirement set forth in that application in which appellants acquiesced." 550 F.2d at 1280, 193 USPQ at 149 (emphasis added). By focusing on the single word "proper" in the above quotation, Watkinson argues that the propriety of the restriction requirement was central to the *Orita* decision, and should be central to our analysis here. Hence, Watkinson dedicates much of her brief to a discussion of the merits of the restriction requirement in the original application and concedes that if the restriction requirement were proper, the '219 patent issued error free.

propriety of simply not a opinion is to the merits of it is unnecessary here. *Orita* previously estants are "ess issue claims w for restriction they could not F.2d at 1280, *In re Cornell*, (CCPA 1945) 747, 57 USPQ *In re Weiler*, USPQ 673, 6 cantly, Weiler patent with in invention. By restriction req divisional appl of non-elected cause that was that subject ma *United States*, 729 F.2d 289, 295 (Fed. rule bars the through reissue or of broader s were canceled ion.") (empha *United States*, USPQ 565, 56 deliberate can obtain a patent the same claim patent.").

Ex parte Holt, 381 (Bd Pat App) opinion adopted (Bd Pat App & 1). Holt's invention is neither birch nor maple, and it supports Watkinson's position on the issue in *Holt* was improper rejection under 35 U.S.C. § 101.

[1] In light of the record and relevant case law, however, we reject Watkinson's argument and hold that the failure to file a divisional application, regardless of the propriety of the underlying restriction requirement, is not an error correctable by reissue under 35 U.S.C. §251.

Contrary to Watkinson's assertion, the propriety of the restriction requirement was simply not an issue in *Orita*. In fact, the opinion is totally devoid of any analysis of the merits of the restriction requirement and it is unnecessary to pursue such an analysis here. *Orita* must be read for adhering to the previously established principle that applicants are "estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent." 550 F.2d at 1280, 193 USPQ at 148 (discussing *In re Cornell*, 150 F.2d 702, 66 USPQ 320 (CCPA 1945) and *In re Smyser*, 135 F.2d 747, 57 USPQ 402 (CCPA 1943)). See also *In re Weiler*, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986) ("Significantly, Weiler accepted issuance of the '923 patent with its claims to a single elected invention. By acquiescing in the examiner's restriction requirement, and failing to file divisional applications on the subject matter of non-elected claims, Weiler foreclosed (because that was not error) his right to claim that subject matter."); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984) ("The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application.") (emphasis in original); *Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). ("[T]he deliberate cancellation of claims in order to obtain a patent constitutes a bar to obtaining these same claims by inclusion in a reissue patent.").

Ex parte Holt and Randell, 214 USPQ 381 (Bd Pat App & Inter), vacated, majority opinion adopted on reh'g, 218 USPQ 747 (Bd Pat App & Inter 1982) cited by Watkinson is neither binding on this court, nor does it support Watkinson's position. The central issue in *Holt* was whether acquiescence in an improper rejection of a Markush claim under 35 U.S.C. §121 (1982)² was an error

correctable by reissue. *Id.* at 383. The board found that the error in not recognizing the impropriety of the rejection was an error sufficient under section 251 and that the appellants' failure to file a timely divisional application should not foreclose them from pursuing section 251 relief. *Id.* at 384. Although Watkinson argues that the board's logic in *Holt* promotes a similar holding in the present case, *Holt* is, in fact, inapplicable. Contrary to Watkinson's assertion, there is a legally significant difference between the rejection in *Holt* and the restriction requirement in the present case. Under *In re Weber*, 580 F.2d 455, 458, 198 USPQ 328, 332 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 464, 198 USPQ 334, 336 (CCPA 1978), it is never proper for an examiner to reject a Markush claim under 35 U.S.C. §121. Section 121 simply does not authorize such a rejection. *Id.* The board's decision in *Holt* not only recognizes this legal principle but explicitly notes that with regard to section 121, the rejection of a Markush claim is different from a restriction requirement between different claims. *Holt*, 214 USPQ at 384 (discussing *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977)). That is, a restriction requirement is "proper" under section 121, whereas the rejection of a Markush claim is not.

Thus, although the impropriety of the rejection of a Markush claim was central to the *Holt* decision, nowhere in *Holt* did the board engage in the kind of analysis Watkinson demands of this court here. Indeed, neither this court nor the board has jurisdiction in this proceeding to review the merits of a requirement for restriction under section 121, as a restriction requirement is a matter within the discretion of the examiner and not tantamount to a rejection of claims. See *In re Hengehold*, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971). The proper time for Watkinson to have challenged the merits of

² 35 U.S.C. §121 reads in relevant part:

§121. *Divisional applications*

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other

invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. . . .

the restriction requirement in the original application was during the prosecution of the original application. Upon compliance with the relevant PTO regulations, Watkinson could have received from the examiner and the Commissioner the consideration she now requests from this court. See 37 C.F.R. §§1.143, 1.144 (1989). However, after acquiescing in the restriction requirement, cancelling the non-elected claim and allowing the '219 patent to issue, Watkinson has lost her opportunity to challenge the propriety of the restriction requirement.³

We agree with the board that this case falls squarely within the holding of *In re Orita* where the court said that section 251 "is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure." 550 F.2d at 1281, 193 USPQ at 149; cf. *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984) ("Reissue is not a substitute for Patent [and Trademark] Office appeal procedures."). Moreover, we will not permit Watkinson to undermine the co-pendency requirement under sections 120⁴ and 121 by using the reissue statute to avoid a restriction requirement in which she acquiesced. See *Orita*, 550 F.2d at 1280-1281, 193 USPQ at 149.

³ We agree with the board that Watkinson's excuse for not challenging the restriction requirement during the prosecution of the original application — that Watkinson's agent mistakenly believed the subject matter of the non-elected claim to be unpatentable — is unpersuasive in light of the fact that Watkinson deliberately chose at the time of the restriction requirement to pursue the patentability of such subject matter in a divisional application and later failed to do so. This issue was not raised by the appellant in the present appeal, however.

⁴ 35 U.S.C. §120 (1982) reads in relevant part: §120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States ... by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Accordingly, the board's decision is
AFFIRMED.

District Court, D. Kansas

Hesston Corp. v. Sloop

Nos. 86-2370-S and 86-2371-S

Decided February 7, 1990

PATENTS

1. Infringement — Literal infringement (§120.05)

Differences between accused balers and patent in suit, regarding degree of compaction of crop material during early stages of bale formation, preclude finding of infringement.

Particular patents — General and mechanical — Crop balers

4,224,867, Gaeddert and Weigand, crop loading monitor for rotary balers, not invalid; infringed.

4,386,493, Holdeman, Gaeddert, Ratzlaff, Pruitt, and Lohrentz, method and apparatus for making large round crop bales, not invalid, but not infringed.

Consolidated actions by Hesston Corp. and Hay & Forage Industries against Don L. Sloop and Massey-Ferguson Inc., for patent infringement, in which defendants counterclaim for antitrust violations and declaratory judgment of patent invalidity. Judgment for plaintiff in part on issue of liability for patent infringement.

Warren N. Williams and Stephen D. Timmons, of Schmidt, Johnson, Hovey & Williams, Kansas City, Mo.; John J. Jurcyk, Jr., of McAnany, Van Cleave & Phillips, Kansas City, Kan., for plaintiffs.

J. Nick Badgerow, of Spencer, Fane, Britt & Browne, Overland Park, Kan.; Rudolph L. Lowell and C. Carleton Frederici, of Davis, Hockenberg, Wine, Brown, Koehn & Shors, Des Moines, Iowa; Carter H. Kokjer, of Kokjer, Kircher, Bradley,

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re John Breuner Co., 136 USPQ 94 (TTAB 1963), Orion argues, and we agree, that repairing of instruments can be a service within the meaning of §45. In Heavenly Creations, however, the service (instruction on styling hair pieces), unlike Orion's guarantee, was not limited to the specific hair pieces sold by the instructors. Accordingly, the instruction was considered a service additional to that normally involved in promoting the sale of one's own goods. Non-mandatory customer services, such as the credit extension service in John Breuner, are not analogous to a sales guarantee or warranty. The board correctly observed that a guarantee to replace or repair one's own merchandise in a given time period would be one of the normally expected duties of a merchandiser. Section 2-314 of the Uniform Commercial Code imposes on a seller of goods an implied warranty that the goods "are fit for the ordinary purpose for which such goods are used." The "service" alleged herein is no more than an express sales warranty or guarantee. U.C.C. §2-313.

The "NO LEMON" guarantee may be an effective promotional and advertising idea designed to advance sales of Orion's instruments. It is not a service adequate to support registration under the Act.

Court of Customs and Patent Appeals

In re Rowand and La Rose

No. 75-549

Decided Oct. 23, 1975

PATENTS

1. Reissue — Same invention as original (§58.7)

It is significant that appealed claims of patent reissue application are directed to method and not to tubing to which original patent claims were directed.

2. Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

Reissue — In general (§58.1)

Determining compliance with Section 251 is first order of business in examining reissue application; since court agrees with Section 251 rejection, it is not necessary to describe in detail or discuss remaining grounds of rejection.

3. Reissue — Same invention as original (§58.7)

Rejection of reissue application on broad premise of U.S. Industrial Chemicals, Inc. v. Carbide & Chemicals Corp., 53 USPQ 6 (US SupCt) can be restated as rejection of patent reissue on broad ground that appealed claims are not "for the invention disclosed in the original patent," as required by 35 U.S.C. 251.

4. Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

Reissue — Same invention as original (§58.7)

Determining what protection appellants intended to secure by their original patent, for Section 251 purposes, is essentially factual inquiry confined to objective intent manifested by original patent; what appellants may have believed before they lost interference cannot affect analysis.

Particular patents — Polytetrafluoroethylene Tubing

3,166,688, Rowand and La Rose, Polytetrafluoroethylene Tubing Having Electrically Conductive Properties, rejection of claims 6 - 10 of reissue application affirmed.

Appeal from Board of Appeals of the Patent and Trademark Office.

Application for reissue of patent of Ronald P. Rowand and Harry William La Rose, Jr., Serial No. 61,417, filed Aug. 5, 1970, for reissue of Patent No. 3,166,688, issued Jan. 19, 1965. From decision rejecting claims 6 - 10, applicants appeal. Affirmed.

James R. McBride, Morgan L. Fitch, Jr., and Fitch, Even, Tabin & Luedeka, all of Chicago, Ill., for appellants.

Joseph F. Nakamura (Jack E. Armore, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Rich, Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals affirming the rejections of claims 6-10, all the claims in application serial No. 61,417, filed August 5, 1970, for reissue of appellants' Patent No. 3,166,688, issued January 19, 1965, entitled "Polytetrafluoroethylene Tubing Having Electrically Conductive Properties." The

application is a division of application serial No. 802,295, filed February 14, 1969, for reissue of the same patent. The rejections were made under 35 USC 251, 102, 103, and under the doctrine of interference estoppel. We affirm on the §251 rejection.

The Invention

Appellants' brief describes their invention as a method for preparing polytetrafluoroethylene (Teflon) tubing having an electrically conductive inner portion formed from a mixture of "natural," i.e., unadmixed, polytetrafluoroethylene and electrically conductive particles, preferably carbon black. We need not go beyond the description of the method in claim 6 of the application, the only independent claim:

6. A method of forming a tube of polytetrafluoroethylene and the like for conducting fluids under pressure and including means for discharge of internal static electricity to the ends of the tube and grounding the same from the tube interior at said ends in order to maintain the polytetrafluoroethylene tubing performance characteristics, comprising the steps of mixing natural polytetrafluoroethylene with electrically conductive particles such that the particles are uniformly dispersed throughout the polytetrafluoroethylene in electrically conductive relation, forming a cylindrical preform having a substantially annular conformation from end to end by filling an inner portion thereof with said mixture and an outer portion thereof surrounding the inner portion exteriorly with natural polytetrafluoroethylene, relatively nonconductive in character, and extruding said preform into a thin wall tubing having an integral polytetrafluoroethylene wall structure for containing fluids under pressure uniformly within said tubing.

[1] It is significant that the appealed claims are not directed to the tubing itself. Appellants' patent No. 3,166,688 contained claims solely to tubing. That patent was placed in interference with an application of Slade, serial No. 196,598, filed May 22, 1962, which copied all five of the claims in appellants' patent. Priority was awarded adversely to appellants as to all the claims in their patent. (The Slade application issued as patent No. 3,473,087, on October 14, 1969. Slade was used as prior art by the PTO in the §102 and §103 rejections.)

The Rejections

The rejection under 35 USC 251 was made on several grounds, among which was the ground that "there is nothing in the original disclosure that would lead one to believe that applicants intended to secure or claim an invention involving the method steps of making a tube." As authority for this ground of rejection, the examiner pointed to "the broad premise of U.S. Chemicals Co. v. Carbide Corp., 315 U.S. 668, 53 USPQ 6" wherein it was stated that "It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original." The board did not specifically agree with the examiner's reasoning that the absence of a limitation of the patent claims in the reissue claims was a proper ground for rejecting the claims as "not being for the same invention as the original patent." Rather, the board provided its own rationale, which was that the method claims "are drawn to a different invention" because "the article defined in the claims of the original patent may be made in many ways."

Opinion

[2] Since determining compliance with §251 is the first order of business in examining a reissue application, *In re Clark*, F.2d , 187 USPQ 209 (CCPA 1975), and since, as indicated below, we agree with this ground of rejection, it is not necessary to describe in detail or discuss the remaining grounds of rejection.

[3] The broad premise of U.S. Industrial Chemicals, Inc. v. Carbide and Chemicals Corp., supra, was reiterated by this court in *In re DeJarlais*, 43 CCPA 900, 233 F.2d 323, 110 USPQ 36 (1956). This rejection can be restated as one on the broad ground that the appealed claims are not "for the invention disclosed in the original patent," as required by §251.

As the examiner pointed out, *nothing* in the original patent would lead one to believe that appellants intended to claim the method invention which they now claim in this reissue application. The title of the patent is "Polytetrafluoroethylene Tubing Having Electrically Conductive Properties." The first sentence of the specification recites: "This invention relates to tubing extruded from polytetrafluoroethylene."

The full title of this case is *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942).

(Emphasizing advantages of method : ours):

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(Emphasis ours.) The stated objects and advantages of the invention do not refer to a method as being part thereof. (all emphasis ours):

Accordingly where the performance characteristics desired for a particular tubing are important the opportunity for inspection afforded by "white" Teflon tubing is of prime importance. This invention is designed to preserve to a large degree the advantages of an opportunity for visual inspection and thus more adequate control in connection with overall inspection and testing procedures. At the same time the tube is designed to provide a definite path for discharge of static electricity from the tube interior. This path is preferably confined to the interior portion of the tubing wall so that the remaining outer portion of the wall forms an excellent dielectric barrier against arcing to the conventional wire braid armored sheath.

We also note that in the patent, in its very brief description of the method for fabricating composite Teflon tube, which appellants now assert to be their invention, they state:

As will be appreciated by those skilled in the art a cylindrical "preform" having concentrically located portions of Teflon material, with the inner portion admixed with a suitable "filler" as will be explained, may be inserted in a ram type extruder and the raw tubing formed thereby with subsequent heating and sintering steps in accordance with known practices so as to obtain a finished extruded Teflon tube product. [Emphasis ours.]

[4] Appellants argued at oral hearing that they considered the tubing claims of the original patent to be adequate protection for the method they contend was also their invention. This erroneous belief is allegedly an adequate basis under §251 for a reissue. Determining what protection appellants intended to secure by their original patent for the purposes of §251 is an essentially factual inquiry confined to the objective intent manifested by the original patent. What appellants may have believed before they lost the interference cannot affect the analysis.

We agree with the board that there is nothing in the original patent evidencing that appellants intended to claim a method of making tubing or that appellants considered the method now claimed to be their invention. The decision of the board is affirmed.

District Court, S. D. New York

Plantronics, Inc.
v. Roanwell Corporation

72 Civ. 1625 (WCC)
Decided Aug. 28, 1975

PATENTS

1. Patentability — Anticipation — In general (§51.201)

Patentability — Invention — In general (§51.501)

Patentability — Tests of — Skill of art (§51.707)

Review of history of art before and after invention is almost always necessary to determine validity of claim; such review, in combination with prescribed prefatory analysis of prior patents and publications, is also usually best way to determine level of ordinary skill in art.

2. Presumption from patent grant — In general (§55.1)

There is prima facie presumption that claimed invention was conceived by named patentee.

3. Construction of specification and claims — By specification and drawings — In general (§22.251)

Claim language must be interpreted in context of complete claim and in light of specification.

4. Defenses — Fraud (§30.05)

Intent to deceive or reckless disregard of duty of candor are required to establish fraud on Patent Office.

5. Construction of specification and claims — "Means" claims (§22.60)

Infringement — Substitution of equivalents — In general (§39.751)

Argument with respect to alleged indefiniteness of claim that if claim is interpreted to cover any support means other than precise structure illustratively disclosed it would lack precision required by 35 U.S.C. 112 is not persuasive, since its uniform adoption would render "means" claims useless and effectively repeal last sentence of Section 112; no patent would be worth much if its coverage were limited to precise structure shown in drawings; indeed, doctrine of equivalents was judicially created to protect inventors by broadening coverage of their patent claims beyond their